No. 628.

Brf. of Carlisle for Petitioner.

Office Supreme Court U.S.
FILED
MAY 14 1900
JAMES H. McKENNEY

IN THE

Supreme Court of the United States.

Filed May 14, 1900.

OCTOBER TERM, 1899.

HOLZAPFEL'S COMPOSITIONS COMPANY, LIMITED,
Petitioner,

vs.

RAHTJEN'S AMERICAN COMPOSITION COMPANY,
Respondent.

BRIEF FOR PETITIONER.

JOHN G. CARLISLE,
WM. McADOO,
R. B. McMASTER,
Counsel for Petitioner.

C. G. Burgoyne, Walker and Centre Streets, New York.

In the Supreme Court of the United States.

OCTOBER TERM, 1899.

HOLZAPFEL'S COMPOSITIONS COMPANY, LIMITED,
Petitioner,

vs.

RAHTJEN'S AMERICAN COMPOSITION COMPANY,
Respondent.

Brief for Petitioner.

This is a petition for a writ of *certiorari* requiring the Circuit Court of Appeals for the Second Circuit to certify to this Court for its review and determination the case of Rahtjen's American Composition Company, appellant, vs. Holzapfel's Compositions Company, Limited, appellee.

The said suit was brought for an accounting and an injunction to restrain the defendant (the petitioner), an English corporation, from using in this country the name "Rahtjen" on a composition or paint made by it in accordance with the formula contained in the expired English patent to Rahtjen. The bill was dismissed at Circuit. On appeal the Circuit Court of Appeals by a divided court, reversed the decision, awarding an injunction, but no accounting.

I.

THE QUESTION RAISED ON THE THRESHOLD OF THE CASE IS WHETHER A PARTY CAN OWN A TRADE-MARK HERE, WHEN HE HAS LOST THAT SAME TRADE-MARK IN A FOREIGN COUNTRY BY THE EXPIRATION OF A PATENT OF THAT COUNTRY, OWNED BY HIM ON THE ARTICLE.

This question, so far as the reported decisions go, is a novel one. Prior to this suit, the line of decisions in this country relate only to the effect of the expiration of a United States Patent on a trade-mark used here. The law has become well settled on that point, and it has been uniformly held by our Courts that the name given to the article during the life of the patent becomes public property when the patent expires.

It was so held in the case of the "Singer Sewing Machine."

Singer Mfg. Co. vs. June Mfg. Co., 163 U. S., 169.
Singer Mfg. Co. vs. Riley, 11 Fed. Rep., 706.
Singer Mfg. Co. vs. Stanage, 6 Fed. Rep., 279.
Singer Mfg. Co. vs. Larsen, 8 Biss., 151.

And in the case of "Yale Locks."

Ex parte Yale & Towne Mfg. Co., 81 Pat. Off. Gaz., 801.

And in the case of "Fairbank's Scales."

Fairbanks vs. Jacobus, 14 Blatchf., 337.

And in the case of "Goodyear Rubber."

Goodyear India Rubber Glove Mfg. Co. vs. Goodyear Rubber Co., 128 U. S., 598.
Goodyear Rubber Co. vs. Day, 22 Fed. Rep., 44.

And in the case of "Leclanche" batteries.

Leclanche Battery Co. vs. Western Electric Co., 21 Fed. Rep., 538; 23 Fed. Rep., 276.

And in the "Castoria" cases.

Centaur Co. vs. Heinfurter, 84 Fed. Rep., 955.

Centaur Co. vs. Killenberger, 87 Fed. Rep., 725.

Centaur Co. vs. Neathery, 91 Fed. Rep., 891.

Centaur Co. vs. Marshall, 92 Fed. Rep., 605.

But the text books and Federal and State decisions may be searched in vain for any discussion or statement of the effect of the expiration of a foreign patent on a trade mark used here (as well as abroad) by the owner of the said expired patent.

The present case raises this question, and it is of great importance to the commercial community at large what the rule to be established by this Court shall be.

The petitioner contends that where a name under which an article has become known in the country in which it was patented becomes public property there, by reason of the expiration of the patent, it becomes public property the world over (except in countries where there may be valid existing patents on said article, unaffected by the term of the foreign patent, which is not the present case).

In this case the article was patented in England in 1873, and the said patent was forfeited in 1880 for non-payment of taxes. During the life of that patent the paint was known as "Rahtjen's Composition" in England and throughout the maritime world. Bottom paint of this description, to be successful, must acquire a wide reputation and have more than a local standing. The ship that paints with it in New York may dock again at Liverpool or Bremen or Genoa or Hong Kong or Melbourne or Rio de Janeiro. A composition like this, therefore, lives its life in the whole maritime world. Rahtjen's paint went around the earth and became known as a patented composition during the life of the English Patent. When the patent expired the generic appellation became *publici juris*, not only in

England but everywhere. Thereafter, the name ("Rahtjen") could never again be appropriated exclusively as a trade-mark even by the inventor or patentee himself. When the invention fell into the public domain it entered with the name which the inventor had given it. If the patentee or his representatives desire to continue the manufacture of the article after the expiration of the patent and desire to protect his or their reputation as manufacturers thereof, he or they must adopt a new and arbitrary trade-mark, and build up the rights of ownership therein exactly as if a stranger.

This contention, while opposed to the opinion rendered herein by Judge SHIPMAN, is supported as follows:

1. By the dissenting opinion of Judge WALLACE, in the Circuit Court of Appeals.
2. By the opinion of Judge WHEELER, sitting at Circuit.
3. By the decision of the Belgian Court of Appeals.
4. By the decision of the Criminal Court in Hamburg.

We shall take these decisions up in the following order:

The Belgian Decision. From the facts stated in this decision, it appears that in 1885 Rahtjen and Suter, Hartman & Co. (the predecessors of Rahtjen's American Composition Co.), brought suit in Belgium against W. Wright, the agent of the London Oil and Colour Co., for putting on the sign of his house the inscription, "Manufacturers of Rahtjen's Composition," and for announcing that he sold "Original Rahtjen's Compositions for Ships' Bottoms, manufactured by the London Oil and Colour Co., Limited." It appeared that Rahtjen, the inventor of the paint and the predecessor of the complainants, had patented the article in England, in 1873, and that this patent was forfeited in 1880. During its life, however, the article

had become known in the maritime world under the generic name, "Rahtjen's Composition." On the expiration of the patent in England, the London Oil & Colour Co., Limited, made the paint in England and shipped it to the defendant to be sold in Belgium under the name "Rahtjen's Composition." The complainants then commenced this action to restrain the unlawful use of the word "Rahtjen." The Brussels Court of Appeals, in reversing a judgment in favor of the complainants, held: (1) That when the English Patent expired any person could make the product in England, calling it Rahtjen's Composition, and that the product so made could be shipped to Belgium and sold there; (2) That any person who could make the article in England and sell it in Belgium could call it in Belgium by the name it had acquired during the life of the English Patent.

Cert. Copy Record, pp. 560–566.

The German decision. From the statement of facts in this decision it appears that in 1897 John Rahtjen instituted criminal proceedings in Hamburg, Germany, against Max Holzapfel and his Hamburg agents, Joost & Schultz, for marking the composition and also the announcements, price-lists, business letters, &c., with the name of "Rahtjen." The facts in the case are very fully stated in the opinion, wherein the fact that Rahtjen was the inventor of the composition, and had sold it for a considerable period under his own name; that on November 29, 1873, he obtained a patent in England for the paint under the title "Preservative Composition for Ships' Bottoms, &c.," but that, owing to failure to pay the tax under the English Patent Law, the patent lapsed, as fully recited, and the Court said, "The manufacture of the paint in accordance with the patent therefore became public property."

The substance of the decision is that the words "Rahtjen's Patent" composition conveys to any in-

terested party no other meaning than that the composition recommended was manufactured in accordance with Rahtjen's Patent. That it could possibly be a preparation of Rahtjen himself, this form of expression was not likely to suggest to any person belonging to the class among whom such goods are sold. The assumption that the goods recommended were supplied from Johann Rahtjen's works was further refuted by the fact that the Holzapfel's Company expressly called itself "Manufacturers of Genuine Rahtjen's Patent Paint," and added, "Warranted made according to Rahtjen's original specification." This addition removed any doubt as to the goods offered not being Rahtjen's manufacture. Besides, this addition was conformable to the truth. The witness Rahtjen himself admitted that the defendant Max Holzapfel doubtless manufactured the paint according to the original patented receipt of his (Rahtjen's) father, which he had found in the specification. Besides, the defendant Max Holzapfel had been most energetic to remove any doubt as to his company being the manufacturer of "Rahtjen's Patent" composition, for he actually referred to their own trade-mark and recommended customers to specially ask for "Holzapfel's" manufacture. Where, therefore, the name of "Rahjen" was so used the possibility of that portion of the public which might be desirous of purchasing goods of this kind being misled as to the origin of the goods was out of the question.

Cert. Copy Record, pp. 571–588.

Judge Wallace's opinion. Judge WALLACE says: "I "am of the opinion that the alleged trade-mark of the "complainant is public property—first, because the "name was the generic description of a *patented* article, "and passed to the public upon the *expiration of the* "*patent.*" He then recites the facts in the present case, and, after dwelling on the Belgian decision, says: "I am at a loss to understand why any different de-

"cision should be made in this country, but the Court "seems to be of opinion that the name is a good "trade-mark here, because no patent was ever ob- "tained for the article in this country, and because "the successors in business of Rahtjen have always "sold it here under the name originally applied to it. "This means that a man can have a trade-mark in "this country in a name which is common prop- "erty everywhere else. If this is good law, then "any person here buying in Belgium, or elsewhere "in Europe, or in England, the article known as "Rahtjen's composition, can be prevented from dealing "in it here under the name by which he bought it. "So long as Rahtjen and his associates and successors "in business enjoyed a monopoly of the manufacture "of the article, the name not only identified the char- "acteristics of the article, but also denoted the source "of manufacture; butwhen the monopoly ceased, and "the article passed into the domain of public prop- "erty, the name which had been its generic designa- "tion also passed. Their monopoly has ceased to ex- "ist in this country as well as abroad, and *the prop- "erty in the name can no more survive here than it can "abroad.*"

See Petition pp. 16 18.

Judge Wheeler's Decision. Judge WHEELER sitting at circuit, in dismissing the bill, said: "Rahtjen's com- "position appears to have become a valuable article of "commerce, well known by that name throughout the "maritime world, through Rahtjen's expired English "patent and his operations under it, so that his name "in connection with trade in that product is descrip- "tive of it and not an indication of its origin as from "him or under his right. The article advertised for by "the Government in calling for the bids which are "claimed to be an infringement or unfair in competi- "tion was this product, however produced, and not the "product produced by or under him. To bid for fur-

" nishing such a well-known article, by whatever name " known that would describe it, would not seem to be " actionable according to any established principles of " law."

Cert. Copy Record, p. 657.

The respondent surely cannot have a trade-mark in this country in a name which is common property everywhere else.

Nor does the Scotch case of Singer Mfg. Co. vs. Kimball, referred to in Judge WHITE'S opinion in Singer Mfg. Co. vs. June Mfg. Co., conflict with the doctrine laid down in the Belgian and German cases, and the opinions of Judges WALLACE and WHEELER, above referred to. That Scotch case which supported the alleged trade-mark in the word "Singer" for a sewing machine did so under the belief that the Singer machine was never patented anywhere, and that there was no generic principle which might be termed the Singer principle shown in those machines.

We quote from the Lord President's opinion in said Scotch case:

" Now, it appears to me that for a series of years, " and certainly, I think, back to the year 1863, as " averred in the petition, everybody in the trade has " understood that a Singer Machine or a Singer Sew- " ing Machine is a sewing Machine manufactured by " the Singer Manufacturing Company. I think that is " the fair result of the evidence. It has hardly been " denied that for that period the fact has been so. But " then reference is made to an earlier period in the " history of the use of this word, as showing that the " meaning thus acquired by the word Singer arose " from false representation made by Mr. Singer and " afterwards by the Singer Manufacturing Company, " or some other Company that preceded them, as to " the right of Mr. Singer, as having a patent or " patents, which enabled him, for a time at least, ex- " clusively to manufacture what was called the Singer

" Machine. Now, no doubt Mr. Isaac Singer, who " appears to be still a partner of this Company, so far " back as 1852, was under the impression that he had " made an original invention, and he expected to obtain " a patent for it, but in that he was disappointed. It " turned out that the straight needle with the vertical " action, which he conceived to be a novelty invented " by himself, had been anticipated in other Sewing " Machines, and the consequence was that he did not " obtain a patent for that.

" But I am not prepared to say that there is any " evidence in this case to show that either Mr. Singer " or any person associated with him in business com- " mitted any fraud in the way of holding out to the " public that they held patents which they did not " hold. I do not think there is sufficient evidence of " that, or that the use of the word Singer, as applic- " able to machines made by him and his company, was " caused by their false representations of patent rights " belonging to him. On the contrary, it rather ap- " pears to me the use of the name grew up and ma- " tured just in consequence of Mr. Singer and those " connected with him in business having constantly " gone on making this kind of machine which he " thought originally was a novelty, and improving it in " every kind of way that occurred to them in the " progress of their business. It was in that way, I ap- " prehend, that the name ' Singer ' came to have what " is now its established meaning, and I cannot see that " there is anything in the history of that appropriation " of the name to prevent the Singer Manufacturing " Company now from asserting right to it as their " trade-mark. It is said, no doubt, on the part of the " defendant, that to interdict him and all other manu- " facturers of sewing machines from the use of this " name involves a great hardship, *because they cannot* " *otherwise describe what they are perfectly entitled to* " *make in their business, machines upon the Singer prin-* " *ciple.* Now, that statement at first sight is very

" plausible, but it seems to me to rest upon a fallacy. " *It assumes that there is* what is called a Singer prin- " ciple—that is to say, that there are some peculiar- " ities in the machines made by the Singer Manufact- " uring Company that are not to be found in any " other machines, or some combination of these " peculiarities that is not to be found in other ma- " chines, and it would be very desirable to ascertain " precisely what that is before disposing of the argu- " ment founded upon these assumptions. But I con- " fess I have looked in vain in the proof for anything " like a definite or intelligible explanation of what is " meant by the Singer principle."

1873, Singer Mfg. Co. vs. Kimball, 11 Cases Ct. of Session, 3 Series, p. 267 (272-3).

The respondent (or appellant in the Court below) contends that its predecessors acquired a common-law trade-mark in this country before making the application for the English Patent.

We know of no rule of law laid down in the text books or in the decisions in this country on this point. We believe the question so raised to be a novel one.

It is true that in the case of Centaur vs. Heinsfurter it would seem that the point was raised by the pleadings whether a man having acquired a common law trade-mark prior to the grant of a patent on the article, could not still retain his trade-mark rights after the expiration of a patent. From the statement of facts printed at the head of the case it would appear that, *prior to 1868*, one Pitcher, the predecessor of the complainant *invented* a medicinal compound *and sold* it under the name of "Castoria." *In 1868* he obtained a patent on the formula. After the patent expired the defendant manufactured the article in accordance with the formula, and sold it as "Castoria." The complainant filed a bill asking that the defendant be enjoined from selling its goods under the name of "Castoria." The Court ignored the point raised by

the allegation of the acquisition of a common-law trade-mark prior to the grant of a patent, and decided that when the patent expired the right to make the article and to sell it as "Castoria" was open to the world (Centaur Co. vs. Heinsfurter, 84 Fed. Rep., 955).

The respondent, in their brief below, cited Batcheller vs. Thomson, 93 Fed. Rep., 660, as supporting its contention that, if its predecessors used said trade-mark two and one-half years prior to obtaining the patent, the subsequent expiration of the patent would not affect the trade-mark rights. That case, however, we submit, does not bear out that contention. The facts of that case are stated by the Court in its opinion: "When Thomson commenced, in Paris and in England, "the manufacture of corsets, they were made in ac- "cordance with an alleged invention of Edward "Drucker. Letters Patent of the United States for "this Corset were issued in the name of Drucker on "May 7, 1867, but the corsets made accordingly were "unsatisfactory; the alleged invention was concededly "of no value, ceased to be used, and an improvement "was made in England by an employee of Thomson, "which was patented in the United States on Novem- "ber 30, 1869, to Henry A. Lyman, assignor to "Thomson, Langdon & Co. This patent expired "November 30, 1886. How closely the corsets of "complainant or defendant followed this improvement "did not appear, and, indeed, the distinctive value "which the improvement imparted to the product did "not appear" (see middle p. 663). * * * "The "Thomson corset was extensively advertised, and was "a favorite, but whether its value was connected with "the Lyman Patent is unknown" (p. 665). These facts are very different from those of the case under consideration, where we have an article of intrinsic merit, made under a patented formula, and deriving its value from the formula, and not from the name.

II.

THE NAME RAHTJEN'S COMPOSITION HAS LONG CEASED TO DENOTE THE SOURCE OF MANUFACTURE, AND BECOME THE GENERIC DESCRIPTION OF THE ARTICLE.

The testimony in this case, of disinterested witnesses, familiar with maritime matters, is to the effect that the maritime world understood Rahtjen's Composition to be a kind of paint, and not as of any particular source (see testimony of Schnitzer, Record, p. 465, Q. 67; Nicholl, Record, p. 492, Q. 11 ; Howden, Record, p. 540, Q. 10 ; Stephens, Record, p. 550, Q. 11).

It was also held in the Belgian decision, and in the German decision, that the name " Rahtjen " had long ceased to denote the source of manufacture.

There are two exhibits in this case to which particular attention is called, as showing that both the English and the United States Governments, respectively, in calling for supplies of Rathjen's composition, recognized it not only as a generic thing, but as having a widely known common formula, by whomsoever manufactured. These exhibits to which we refer, are the letter from the Royal India Office (p. 651) and the U. S. Government proposal for bids (p. 29). As said by Judge WHEELER in the Court below : " The article advertised for by the Government in calling for the bids which are claimed to be an infringement or unfair in competition was this product, however produced, and not the product produced by or under him " (Rahtjen).

This paint then has become generically known as " Rahtjen's "—the name has become part as it were of the thing itself. The public knows it as " Rathjens." It is a generic designation, and has no reference to the source of manufacture, as is shown by the action of the respondent in this case printing and painting on and about its goods the words " Hartman's Manu-

facture" (see p. 82), thus unqualifiedly recognizing that there were different manufactures and sources of the generic thing known as "Rahtjen's Composition."

III.

THE ACT OF THE PREDECESSORS OF THE RESPONDENT IN DISCLAIMING THE EXCLUSIVE USE OF THE WORD "RAHTJEN" WHEN THEY APPLIED FOR THE REGISTRATION OF A TRADE-MARK IN ENGLAND ESTOPS RESPONDENT FROM CLAIMING SUCH EXCLUSIVE RIGHT NOW IN THIS COUNTRY.

Bearing in mind the forfeiture of the English Patent for Rahtjen's Composition in 1880, and the fact that the name Rahtjen's Composition had become public property, we now call attention to the following efforts made by the respondent's predecessors to secure a trade-mark in England:

(1) On June 25, 1883, John Rahtjen filed an application for registration of the words "Genuine Rahtjen's Composition for Ships' Bottoms, &c." ("Defendant's Exhibit Cert. Copy Record of Application, [illegible]position and Withdrawal or John Rahtjen, No. 32,826 of 1883," Printed pp. 627–630). This was after the English Patent to Rahtjen had been forfeited and after the defendant's predecessors had commenced to make and sell (May, 1883) Rahtjen's Composition, Holzapfel's manufacture. M. Holzapfel & Co., through their solicitors, filed a written notice of opposition to the registration sought (p. 629). Rahtjen filed no counter statement, and his application was held to be withdrawn and abandoned (p. 630).

(2) On July 7, 1883, John Rahtjen filed an application for registration of the words "Rahtjen's Composition"

("Defendant's Exhibit Cert. Copy Record of the Application, Opposition and Withdrawal of John Rahtjen, No. 32,952 of 1883," Printed, pp. 623–626). This was after said English Patent had been forfeited and after the defendant's predecessors had commenced to make and sell "Rahtjen's Composition, Holzapfel's manufacture." M. Holzapfel & Co., through their solicitors, filed a written notice of opposition to the registration sought (p. 625). Rahtjen filed no counter statement, and his application was held to be withdrawn and abandoned (p. 626).

(3) On June 28, 1883, Suter, Hartmann & Co. filed an application for registration of the words "Rahtjen's Patent Composition for Ships' Bottoms, Buoys, &c. None Genuine without this signature. Suter, Hartmann & Co." ("Defts.' Exhibit Cert. Copy Application, Opposition and Withdrawal of Suter, Hartmann & Co., No. 32,858 of 1883," Printed pp. 631–635). This was after the English Patent to Rahtjen had been forfeited, and after the defendant's predecessor had commenced to make and sell "Rahtjen's composition, Holzapfel's manufacture." M. Holzapfel & Co., through their solicitors, filed a written notice of opposition to the registration sought (p. 633). Suter, Hartmann & Co. filed no counter statement, and their application was held to be withdrawn and abandoned (p. 634).

(4) On January 9, 1884, Suter, Hartmann & Co. filed an application for registration of the words "Rahtjen's Patent Composition for Ships' Bottoms, Buoys, &c. Directions. Suter, Hartmann & Co." ("Defendant's Exhibit Cert. Copy Suter, Hartmann & Co.'s Application for Trade-mark 34,919 of 1884," Printed pp. 636–638); and in their application appears this DISCLAIMER: "*We do not claim the exclusive use of the words 'Rahtjen's Patent Composition for Ships' Bottoms, Buoys, etc. Directions,' or any of such words, except as part of the combination constituting our trade-mark, as represented annexed, and to which we claim exclusive right.*"

This is a full disclaimer of any exclusive right to the words Rahtjen's Patent Composition, or any of those words, except when accompanied by all of the other words above quoted, and your petitioner has never used said combination of words.

Where the plaintiff has disclaimed the exclusive use of W. R. as a trade-mark to be stamped on goods, *held*, that he cannot restrain the defendant from using the letters W. R. on the same class of goods.

(1892) Rosenthal vs. Reynolds, 61 L. J., Ch., 508.

So, when the applicant for registration of a trade-mark restricted himself in his application to a *red anchor*, the Court refused to recognize his claim to the unlimited use of the anchor emblem. The Court said: "He thereby gave public notice to all traders and others in the United States that he adopted as his trade-mark for medical compounds, not the representation of an anchor generally, but a red anchor in a white oval space or field. This limited registration was a very deliberate act of the plaintiff, and he must abide the consequences. It would be a perversion of the right of registration under the Act of Congress, of which the plaintiff availed himself, and would amount to a fraud on other traders to permit the plaintiff now to *assert broader rights* in the anchor as a trade-mark symbol than his public registration in 1885 disclosed."

(1892) Richter vs. The Anchor Remedy Co., 52 Fed., 455.

IV.

THE RESPONDENT, HAVING STOOD SILENTLY BY FOR VERY MANY YEARS AND ALLOWED THE PETITIONER'S PREDECESSORS TO BUILD UP AN ESTABLISHED BUSINESS IN "RAHTJEN'S COMPOSITION," AND THE BUSINESS HAVING BEEN SUBSEQUENTLY INCORPORATED WITH A LARGE CAPITAL AND NUMEROUS NEW STOCKHOLDERS, IS FOREVER ESTOPPED FROM ENJOINING OR INTERFERING WITH THE PETITIONER'S USE OF THE WORD "RAHTJEN'S."

The respondent and its predecessors in business have known for the past sixteen years that the petitioner and its predecessors in business were making and selling openly and notoriously a composition for ships' bottoms under a name of which the word "Rahtjen" formed part. This was well known to the founders and directors of the English or parent company, from whom the respondent company derives its rights (if any), and who are also directors and owners of the majority of the capital stock in the respondent company.

Your petitioner and its predecessors have continuously, since 1883, advertised its Rahtjen's Composition extensively, and have spent from £1,500 to £1,800 for such purpose annually (p. 424, Q. 69), and built up an active competition with the respondent and its predecessors, and finally outstripped them. The testimony is undisputed that your petitioner's business in these composition paints for ships' bottoms is to-day larger than that of any other company of the like nature in the world (p. 439, Q. 156, x-Q. 157; p. 519, Q. 63; p. 521, x-Qs. 68, 69).

Thus, from 1883 to the present time, your petitioner or its predecessors, acting in good faith and on what we submit was its legal rights, has been continuously, openly and notoriously supplying quantities of Holzapfel's Rahtjen's Composition in England, in Europe

and abroad, and in the United States. During that time its business in these paints has grown until now it is the largest one of its kind in the world. During that time from a partnership it has grown into a large and wealthy corporation, with many new parties in this country and abroad interested therein as stockholders, and the value of its property, of which the paint in question forms part, has, owing to its exertions and expenditure of money in advertising and pushing the same, immensely increased. During all this period of 16 years the respondent and its predecessors, with full knowledge of the facts, stood silently by without any assertion of its alleged rights and without even a notice or protest to the defendant.

JOHN RAHTJEN admits that he was aware, at the time he applied for a registration of this alleged trade-mark in England, in 1883 (which application was successfully opposed by petitioner's predecessors), that petitioner's predecessors were then using on their paint the alleged trade-mark or trade-name in question (p. 225, x-Qs. 401–404), and that petitioner's predecessors, and defendants, have since continued to do so.

WILLIAM HARTMANN, of Suter, Hartmann & Co., (predecessors of complainant), also knew of such use. He says he knew of it soon after Holzapfel & Co. had commenced business (p. 109, fol. 325). He was shown the circular of M. Holzapfel & Co., dated April 17th, 1883 (Defendant's Exhibit, Holzapfel & Co.'s Circulars, Advertisements, Letter Heads, &c.), in which Holzapfel & Co. announce that they are making and selling a Rahtjen composition, according to the specification of the Rathjen Patent, and he says he saw that notice about the time it bears date—to wit, April 17, 1883 (p. 129, x-Qs. 288, 289). Moreover, it is a matter of record that the 1883 application of his firm of Suter, Hartmann & Co., for registrations of said alleged trade-mark, was successfully opposed and defeated by Holzapfel & Co., your petitioner's predecessors.

Suter, Hartmann & Co., were afterwards ... ed into the Suter, Hartmann and Rahtjen's Composition Company. This Company is largely interested in the Rahtjen's American Composition Company (the respondent), the latter being an off-shoot of the parent company in England (p. 127, x-Q. 290). These predecessors of the respondent in the ownership of the alleged trade-mark were also its predecessors in the business it is now carrying on. The sixteen years' laches in England of its predecessors is, therefore, pertinent in the case. The respondent took said alleged trade-mark by assignment from assignors, who had for sixteen years been guilty of laches in the assertion of their alleged monopoly. The respondent stands in the place of such predecessors, and took the assignment of the alleged trade-mark, subject to the legal consequences of the assignors' laches for sixteen years.

The petitioner and its predecessors sold "Rahtjen's Composition, Holzapfel's Manufacture," in the United States continuously ever since they began in 1883 to make and sell it in England. At this long interval of time it has been impossible to get competent evidence of the *first* knowledge of the agents in this country of respondent's predecessors.

But Clark, a witness for the respondent, who was called to prove that his deceased father was agent in this city from 1886 to 1888, inclusive, for the Rahtjen's composition of respondent's predecessor, and that he (the witness) was in such agent's employ at that time, says that he knew Donald & Co. to be the agents in this city of Holzapfel's Rahtjen's composition 12 or 13 years ago (p. 257, Qs. 22, 24). He had a conversation with Donald about it, and was cross-examined as follows:

Re-x Q. 32. When Mr. Donald solicited you to buy the Rahtjen's composition made by Holzapfel was not what he told you as follows: That it was made according to the same formula as the Rahtjen's composition which you were familiar with?

Same objection as to x-Qs. 20, 21, 23 and 24.

A. Yes, sir; that was his idea of it.

Re-x-Q. 33. You knew at the time, did you not, that the Rahtjen's composition Holzapfel's manufacture, which Mr. Donald solicited you to buy, was not made by the same firm or manufacturer who made the Rahtjen's composition with which you were familiar?

Same objection.

A. Well, being different firms, no, I never thought it was the same people who were manufacturing the paint.

Re-x-Q. 34. And you did not intend in your testimony to be understood that Mr. Donald represented to you that it was the same people who were making the paint?

A. No, the same formula.

Re-x-Q. 35. You knew then that there were two rival establishments making the paint, but understood that the paint made by both were from the same formula?

A. Mr. Donald gave me to understand that (p. 259, Re-x-Qs. 352-35).

Various other witnesses in the United States have testified to the continuous competition for orders for Rahtjen's Composition, between the petitioner and the respondent, and it was well known in the shipping circle of this city for 12 years past that there were two Rahtjen's Compositions for sale—viz., Hartman & Co.'s Rahtjen (for sale by Petersen) and Holzapfel's Rahtjen (for sale by Donald & Co.).

See testimony of—

Coverly, a clerk in the office of Henderson Bros. (p. 387, Qs. 8–10).

Haffner, chief clerk for Bowring & Archibald (p. 390, Qs. 11–19).

Orington Linnekin, superintendent of the New York Dry Dock and Repair Co., East River, N. Y. (p. 393, Qs. 8–14).

John Adair, superintendent of the Tweedy Trading Co. (p. 396, Qs. 11–16; p. 397, Q. 21). Adair also knew of the Rahtjen Composition made by Holzapfel's in England years ago.

Q. 28. You can state any prior instance to the painting of the "Aguan," where you have had personal dealing or transaction with Rahtjen's Composition, Holzapfel's manufacture? A. I had it put on a steamer at Newcastle, England, about thirteen years ago; thirteen to fourteen; I am not sure as to the date.

Q. 29. Do you mean that you had a steamer painted with it at Newcastle, England? A. Yes.

Q. 30. Do you remember the name of the steamer? A. "Totomo Maru."

Q. 31. Do you remember any other instance when you had any dealing in Rahtjen's Composition, Holzapfel's manufacture? A. Yes.

Q. 32. You may state what? A. At the same time I took out a consignment to Japan.

Q. 33. You mean a consignment of Rahtjen's Composition Holzapfel's manufacture?

A. Yes.

Q. 34. What did you do with the consignment when you arrived in Japan? A. Sold it to the Japanese Government.

P. 398, Qs. 28–34.

Oswald Miller, superintendent for R. W. Cameron & Co. (p. 402, Qs. 11–13; 22–27).

Mr. Andresen, assistant manager of petitioner's company's office in New York City, cites an instance to show that *Mr. Petersen*, the agent for the respondent's predecessors (and the now president of the respondent corporation) knew that Donald & Co. were selling Rahtjen's Composition Holzapfel's manufacture, at least as early as 1891 (p. 345). *Mr. Petersen* himself admits that he knew Donald & Co. were advertising Rahtjen's Composition Holzapfel's manufacture, at least as early as 1892 or 1893, and that his company made no objection or protest (p. 45, x-Qs. 140–145). He saw their advertisement in the "Maritime Register" in 1893 (p. 56, x-Q. 209). He also heard rumors from abroad, and from his own agents, that petitioner's Rahtjen paint was offered in the market (p. 56, x-Q. 227), and that he had in mind the petitioner's company when he issued the circular in 1893 (p. 60, x-Q. 246).

Was this "easy indifference" of the respondent and its predecessors commendable? Was not the course of conduct of the respondent and its predecessors during these 16 years directly to encourage the petitioner and its predecessors in the use of the alleged trade-mark? Is the respondent at this late day and in view of the

changes which the lapse of time has wrought, entitled to any relief in this Court? Such undue and unexplained delay under the circumstances, we respectfully submit, renders it inequitable to grant an injunction.

The cases are many in which this defense of laches has been invoked and considered. It is true that by reason of their difference of fact no one case becomes an exact precedent for another, yet a uniform principle pervades them all. They proceed on the assumption that the party to whom laches is imputed has knowledge of his rights, and an ample opportunity to establish them in the proper forum; that by reason of his delay the adverse party has good reason to believe that the alleged rights are worthless, or have been abandoned, and that, because of the change in condition during this period of delay, it would be an injustice to the adverse party if the stale claim were now permitted to be enforced.

In *Mackall vs. Casilear*, 137 U. S., 556, this Court said:

"The doctrine of laches is based upon grounds of "public policy which requires for the peace of society "the discouragement of stale demands. And where "the difficulty of doing entire justice by reason of the "death of the principal witness or witnesses, or from "the original transaction having become obscured by "time, is attributable to gross negligence or deliberate "delay, a Court of equity will not aid a party whose "application is thus destitute of conscience, good "faith and reasonable diligence."

In *Hammond vs. Hopkins*, 143 U. S., 224, 250, this Court said:

"No rule of law is better settled than that a court "of equity will not aid a party whose application is "destitute of conscience, good faith and reasonable "diligence, but will discourage stale demands, for the "peace of society, by refusing to interfere where there "have been gross laches in prosecuting rights, or

" where long acquiescence in the assertion of adverse " rights has occurred."

In *Abraham vs. Ordway*, 158 U. S., 416, this Court said :

" One of the grounds upon which courts of equity " refuse relief where the party is guilty of laches is the " injustice of imposing upon the defendant the neces- " sity of making proof of transactions long since past " in order to protect himself in the enjoyment of rights " which, during a considerable period, have passed un- " challenged by his adversary, with full knowledge of " the circumstances."

This principle of equity jurisprudence is, of course, applicable to patent and trade-mark suits, and has been followed by the Circuit Court of Appeals in the following well-known cases :

In *Prince's Metallic Paint Co. vs. Prince Mfg. Co.*, a purchaser on foreclosure of a property and business which had long been conducted in connection with a trade-mark, continued to use the trade-mark, with full knowledge of the former owner, for eight years without objection. The Court said :

" In courts of equity the rule is to withhold relief " where there has been unreasonable delay in prose- " cuting a claim, or long acquiescence in the assertion " of adverse rights. Again and again it has been " judicially decided that nothing can call into activity " a court of equity but conscience, good faith and rea- " sonable diligence. In McLaughlin vs. Railway Co., " 21 Fed., 574, Judge BREWER held a bill for infringe- " ment of a patent, alleging use and construction of a " patented invention for 13 years without stating an " excuse for the plaintiff's delay in suing to be demur- " rable. Laches for even less than the statutory " period of limitations, aided by other circumstances, " will bar a right (Ashhurt's Appeal, 60 Pa. St., 290). " In Lewis vs. Chapman, 3 Beav., 133, the Master of " the Rolls refused an injunction to restrain the in- " fringement of a copyright solely on the ground of 6½

" years' delay, where there was knowledge of the com-
" mencement and prosecution of the defendant's pub-
" lication. Long acquiescence before filing a bill for
" an injunction, with full knowledge of the infringe-
" ment, is deemed laches equivalent to a breach of
" good faith (Brown, Trade-Marks, § 497). Hence, in
" Manufacturing Co. vs. Garner, 55 Barb., 151, a delay
" of nine years in applying for an injunction to restrain
" infringement of a trade-mark was held to be a good
" cause for refusing it." The bill in the above case was dismissed.

(C. C. A., Sept., 1893.) Prince's Metallic Paint Co. vs. Prince Mfg. Co., 57 Fed., 938 (944); affg., s. c., 53 Fed., 493.

In *La Republique Francaise vs. Schultz* the defendant had for 30 years manufactured and sold "Vichy water," during which period his said business had grown to a large and profitable one. He always associated his name with his product, and advertised it as "Schultz's Vichy Water." (Just as the defendant in the present suit has always advertised its product as Holzapfel's Rahtjen's Composition or Rahtjen's Composition, Halzapfel's Manufacture.) Judge WALLACE, in deciding this case at Circuit, said:

" Equity is indisposed to assist parties who have
" slept upon their rights and acquiesced in their ap-
" propriation by others for a great length of time.
" The unexampled delay and acquiescence in the pres-
" ent case, I think, should defeat the action."

The bill was dismissed.

(C. C., May, 1899.) La Republique Francaise vs. Schultz, 94 Fed., 500. (Since affirmed by the Circuit Court of Appeals.)

In *Saxlehner vs. Eisner & Mendelson Co.* the complainant made the Apollinaris Company his agent in the United States in 1876, for the exclusive sale of his Hunyadi Janos Water, put up in bottles with a distinctive red and blue label. All went well until 1888,

nine years before the beginning of the suit, when infringements commenced and continued uninterruptedly during that period. To check this appropriation of his trade name and trade label in the United States, Saxlehner did nothing during these nine years. The Apollinaris Company, whom he had over his signature proclaimed to the world as the suppressor of infringements, in 1889, and again in 1890, announced that it had adopted an additional trade-mark of selection *(a red diamond)*, which was to distinguish the Hunyadi Water sold by it. *This is analogous to the appellant and its predecessors, adopting the "Red Hand" after the alleged infringements had commenced, and laying stress upon the fact that no Rahtjen's Composition was of their manufacture unless stamped with the red hand.)* In deciding the case the Circuit Court of Appeals said:

"In view of these facts, of the continued and in-
"creasing appropriation by competitors of his label
"and of his trade name (as a generic designation), can
"a complainant, who has for nine years done nothing
"towards maintaining or even asserting his original
"rights, now be heard to suppress the competition
"which his supineness has allowed, and, indeed, in-
"vited and encouraged to grow up? We think not."

(C. C. A., Jan., 1899) Saxlehner vs. Eisner & Mendelson Co., 91 U. S., 536.

In *Starrett vs. Stevens Arms & Tool Co.*, it appeared that the compainant was aware ten years before bringing suit that the defendant was manufacturing and selling the alleged infringing device, and that at that time complainant had a correspondence with defendant in reference to the proper construction of complainant's patent and alleged infringing device made by defendant, but did nothing more to pursue his claim for the following ten years, during which time defendant continued to manufacture the alleged infringing device, and built up a large and profitable business therein.

(The present case is even stronger than this, since no claim or demand was made by the appellant or its predecessors on the defendant or its predecessors before suit was brought, 16 years after the alleged infringement commenced.) The Court said :

" It would operate as a great injustice at this late " day to interfere with an established business con- " ducted under an open claim of right for so many " years. The laches in this case are such as to debar " not merely the claim for profits, but any claim to the " interposition of a court of equity ;" and the bill was dismissed.

(C. C., July, 1899, Starrett vs. Stevens Arms & Tool Co., 96 Fed., 244.

In Richardson vs. Osborne & Co. the complainant for about fourteen years witnessed the infringement of his patent by the defendant, during which time the defendants expended time and money in building up their business. The Circuit Court of Appeals, in deciding the case, said :

" The complainant says he sent notices to the man- " ufacturers, and, among others, to the defendant cor- " poration, in the latter part of 1883 and met the presi- " dent in Lake City by appointment in January, 1884. " He says : ' We had some conversation. He asked " ' what our claim was. He was told it was on the " ' combination. We talked together perhaps fifteen " ' minutes pleasantly.' In May, 1890, an action at " law was brought against the Minneapolis Harvester " Works, which was compromised before trial, in Sep- " tember, 1891, by the payment of money and a re- " lease by the complainant. He did not tell how much " money was paid or whether it was in recognition of " the validity of the patent. For aught that ap- " pears, all that the defendant did was to pay " a trifling sum to be free from a lawsuit. " No other proceeding was instituted until the " present suit. The only thing which can be " during the entire history of the invention character-

" ized as an active exercise of ownership was the Min-
" neapolis suit, and its outcome is so vague and
" shadowy that it cannot be told whether it was a suc-
" cessful or an abandoned attempt to sustain the patent.
" The continued refusal or neglect of the joint owners
" to impart life to it was so manifest that a Court can-
" not look with favor upon the present attempt to gain
" money from manufacturers who invested in the effort
" to supply the demands for the Appleby machines,
" under the belief that it infringed no patent, a belief
" which the conduct of the owners of the Fowler Pat-
" ent encouraged." The decision below dismissing the bill for laches was affirmed.

(C. C. A. Apr., 1899.) Richardson vs. Osborne & Co., 93 Fed., 828, affirming s. c. 82 Fed., 85.

In the present suit (whether we consider the 16 years in England, or the 12 years in the United States, of the uninterrupted use of the alleged trade-name, by the defendant or its predecessors) there was such inexcusable laches that the decree of the Circuit Court dismissing the bill of complaint, should have been affirmed by the Circuit Court of Appeals.

Conclusion.

We respectfully urge upon the Court that this case partakes of international and public interest, not only affecting the whole maritime world, but being of especial interest to the Government of the United States. It is in evidence on the record, as the Court will see, that the complainants in the court below admitted by the witness Petersen (Record, pp. 51 and 52, x-Q. 187, x-Q. 188, x-Q. 189, x-Q. 190) that the main reason for bringing suit was the successful competition and un-

derbidding of them in the matter of price for this paint for the Navy Department. In this respect the Government of the United States is an interested party in this case, in the efforts of the petitioners to break down a monopoly, beget healthful competition and lower prices to the great benefit of the Government. The case is also of lively international interest, as it will make an article of prime necessity in the shipping world a monopoly in the United States while subject to free competition in every other port in the world. If the decision of the Circuit Court of Appeals stands, while it will be legal for anyone to sell under the brand of 'Rahtjen' a paint for ships' bottoms in Great Britian and Europe, the same paint with this brand on cannot be obtained in the United States unless by paying tribute to the monopoly, which will result from the present decision. What will be lawful and proper in the whole shipping world outside of the United States will be a crime here. An article in which the name is part of the thing itself, woven into the very fibre of its existence will here become an exclusive property under that monopolistic form which is odious to the law, while free as air to the use of everyone outside the jurisdiction of this Court.

It is respectfully submitted that in view of the novel questions involved in this case and upon all the facts thereof, this petition for a writ of *certiorari* should be granted.

JOHN G. CARLISLE,
WM. MCADOO,
R. B. MCMASTEN,
Counsel for Petitioner.

Office Supreme Court U. S.
FILED
SEP 29 1900
JAMES H. McKENNEY,
Clerk.

No. 267. 54.

Brf. of Sands for Petitioner (on mo.)

Filed Sept. 29, 1900.

In the Supreme Court of the United States,

OCTOBER TERM, 1899.

No. 267.

HOLZAPFEL'S COMPOSITIONS CO. (LIMITED), *Petitioner*,

vs.

RAHTJEN'S AMERICAN COMPOSITION CO., *Respondent.*

Objections to Motion of Respondent.

Now comes the petitioner in the above-entitled cause, by its counsel, and submits to this Honorable Court these its objections to the motion submitted this 28th day of May, 1900, in behalf of the said respondent by its counsel.

And for grounds of objection petitioner states that no proper or sufficient notice of said motion has been served upon the petitioner above named or its counsel; a copy of said motion, and of the petition annexed thereto, having been handed to petitioner's counsel, at their office in New York, *after the hour of 12 o'clock, noon*, on Saturday, May 26, 1900, less than 24 hours (excluding Sunday) prior to the submission of said respondent's motion to this Honorable Court.

Secondly. Because the motion is frivolous, inasmnch as it simply asks of this Court to duplicate the writ of certiorari to the Honorable the Judges of the United States Court of Appeals for the Second District, already granted on this petitioner's motion in this cause, to wit, on the 21st day of May, 1900, which action by this Court renders the present motion unnecessary.

Thirdly. And your petitioner further states that the reason for the motion advanced by the respondent in his petition, paragraph II, to wit, that the Court of Appeals below "erroneously refused an accounting for damages or profits" being clearly a matter within the discretion of the Court below, and finally decided there, presents a question upon which error is never assignable (see Phillips Practice, Sup. Ct., second edition, page 184, Chap. XXII. and the many authorities cited), and its finality was conceded by the respondent in his brief in opposition to this petitioner's application for the writ, when on page 9 of brief he makes the denial of damages by the Court below the basis of an argument against the issuance of the writ on petitioner's application in the following language, to wit:

"The defendant can be subjected to no loss whatever as "to the past, because there is no accounting in damages "The only detriment to which it (the defendant corporation) "can possibly be subjected, is being prevented from making "sales of Rahtjen's Composition to parties demanding it in "preference to the petitioner's own brand, viz.: "Interna-"tional;" or, in other words, from selling to the customers "of the respondent instead of its own. Its legitimate busi-"ness can in no wise be affected by the present decree and "injunction."

This was the argument used against the granting of the writ of certiorari prayed for by the Holzapfel's Compositions Company, which this Court granted notwithstanding the opposition so made—and as this opposition so expressed in that brief recognized that it was satisfied with the advantage it had so gained in the Court below to the great injury of the defendant company—it cannot now, in reason, ask that the question of damages should be made the subject matter of argument at the hearing on the merits—to divert the attention of this Court from the consideration of the

issues of law involved in the hearing granted which go to the respective rights of the parties to the use of the word "Rahtjen" the only issue in the controversy upon bill—answer and evidence.

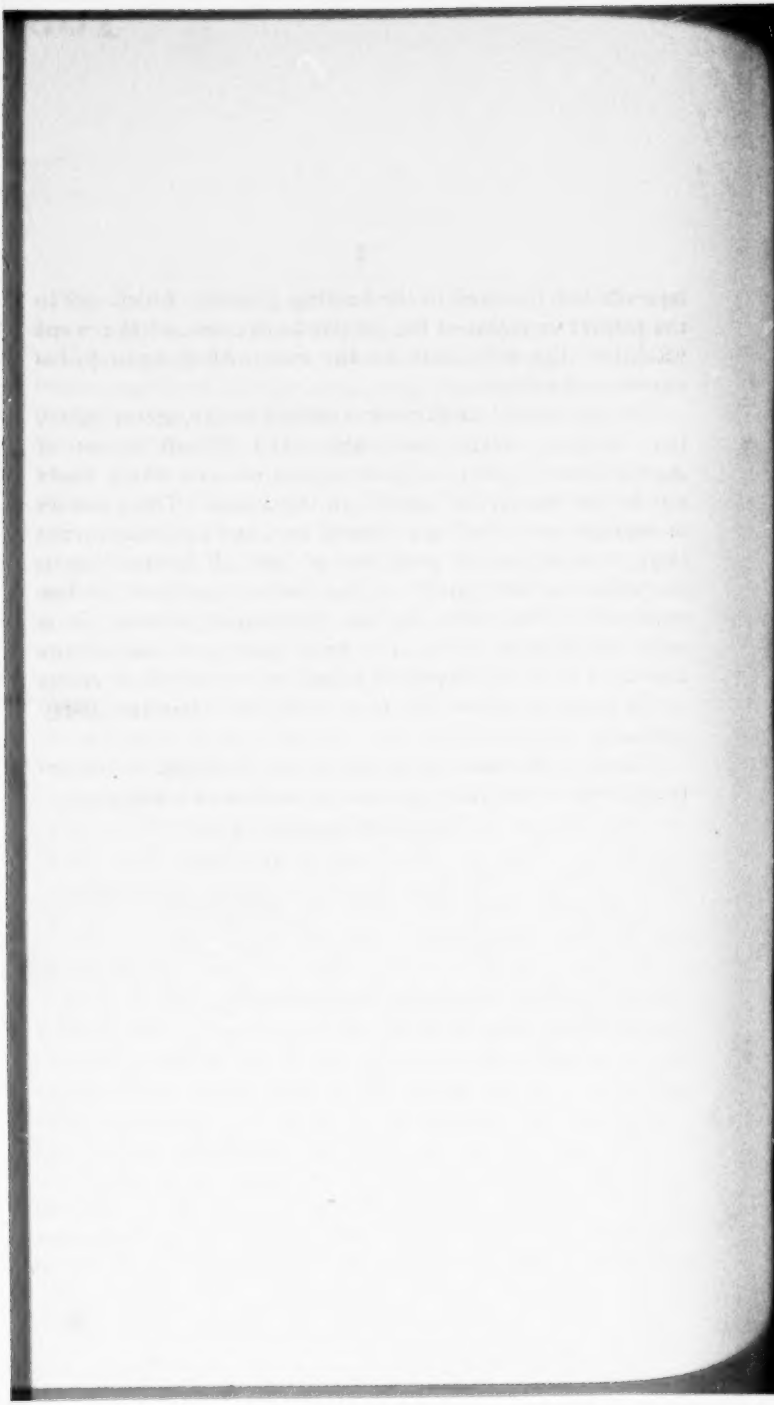
The question of damages was settled by the decree below, that being a matter over which the Circuit Court of Appeals had full and exclusive discretion, and which could not be the subject of appeal to this court. The question of damages is entirely a collateral one, and confined to the facts, on well settled principles of law. It has nothing to do with the settlement of the novel question of law presented in this brief, by the petitioners herein. It is only intended to cloud the real issue, and divert the argument from the questions raised by the manifest errors in the decision below and from which the defendant petitioner appealed.

Wherefor, we most respectfully ask a denial of the petition filed by the Respondent, the Rahtjen's Company.

Respectfully submitted,

F. P. B. SANDS,

of Counsel for Petitioner.



No. 267.

Brf. of Carlisle for Petitioner

Office Supreme Court U.S.
FILED
APR 15 1901
JAMES H. McKENNEY,
Clerk.

Filed April 15, 1901.

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1900.

No. 267.

HOLZAPFEL'S COMPOSITIONS COMPANY, LIMITED,

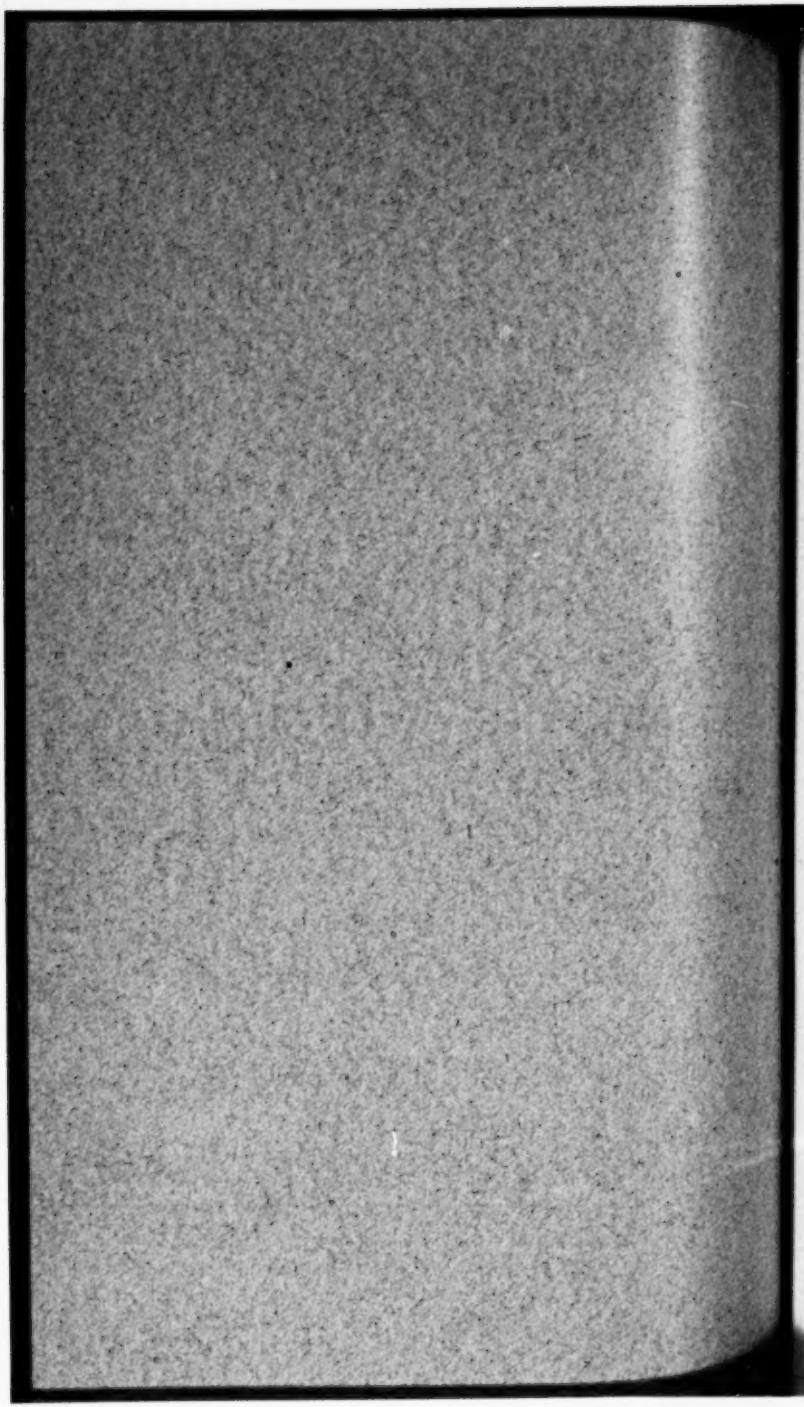
vs.

RAHTJEN'S AMERICAN COMPOSITION COMPANY.

BRIEF FOR HOLZAPFEL'S COMPOSITIONS COMPANY, LIMITED.

JOHN G. CARLISLE,
WM. McADOO,
R. B. McMASTER,
Counsel for Holzapfel's Compositions Company, Limited.

C. G. Burgoyne, Walker and Centre Streets, N. Y.



Supreme Court of the United States.

OCTOBER TERM, 1900.

No. 267.

HOLZAPFEL'S COMPOSITIONS COMPANY, LIMITED,

vs.

RAHTJEN'S AMERICAN COMPOSITION COMPANY.

BRIEF FOR HOLZAPFEL'S COMPOSITIONS CO., Limited.

Statement of Facts.

This case comes before this Court on *writ of certiorari* requiring the Circuit Court of Appeals for the Second Circuit to certify to this Court for its review and determination, the case of Rahtjen's American Composition Company, Appellant vs. Holzapfel's Compositions Company, Limited, Appellee.

The said suit was brought for an accounting and an injunction to restrain the defendant, an English Corporation, from using in this country the name "Rahtjen" on a composition or paint for ships' bottoms.

The answer set up that the composition had been patented in England, and that said patent had been forfeited in 1880; that thereby the name "Rahtjen," by which the article had become known during the life of the patent, had become public property. It also pleaded efforts made by the complainant's predecessors to obtain registered trade-marks therefor, and successful opposition made thereto by defendant's predecessors, resulting in a disclaimer to the word "Rahtjen" filed by complainant's predecessors. It also set up that complainant's predecessors had not marked the vessels containing the composition with the alleged trade-mark until after the defendant's predecessors had entered the field. It also alleged fatal laches on the part of the complainant and its predecessors. It denied unfair competition.

A large amount of testimony was taken abroad, by both parties to the suit, relating to the English history of the alleged trade-mark.

The undisputed facts in the case, are as follows:

One Rahtjen invented a composition for ships' bottoms, and in 1871 and 1872 made a few experimental sales thereof through Suter, Hartmann & Co., in England, and through Henry Gelien, in the United States.

In 1873, Rahtjen patented the composition in England. He desired to patent it in the United States, but feared that his application for a patent here would be refused for lack of novelty or invention. Thus he wrote Gelien: "It appears from inquiries made that it will be very difficult in the United States to obtain a patent, one of the reasons for this being that my paint contains some ingredients which are already known as components of paint, and the Patent Office will probably object to this and reject the application for the patent. But in my opinion, it is better to forego the patent, rather than apply for a patent and receive a refusal" (Record, p. 189).

In 1880 the patent was forfeited for non-payment of taxes under the English Patent Law..

On April 21, 1883, M. Holzapfel & Co., of Newcastle-on-Tyne, the predecessors in interest of the defendant, commenced to manufacture the said composition in accordance with the expired patent, and to sell the same under the name "Rahtjen's Composition," that being the name it was known by during the life of the patent. On the same day, they filed their first application for registered trade-mark in England, which was granted, and they subsequently obtained registration in England for several modifications of the same. In all of these applications they disclaimed the *exclusive* right to the use of the word "Rahtjen." One of the foregoing trade-marks they also registered in the United States. Subsequently they registered the representation of a propeller. All of these trade-marks are now owned by the defendant.

On April 27, 1883, one of the complainant's predecessors applied for registration in England of an open "Red Hand" surrounded by the words "Genuine _____ Composition. Trade-Mark. Hartmann's Manufacture," as a trade-mark for their composition, and this was granted, and ever since has been used by complainant and its predecessors as a distinguishing trade-mark to mark said composition made by them; and complainant and its predecessors have laid stress upon the fact that no Rahtjen's Composition was of their manufacture unless stamped with the "Red Hand."

In June, 1883, after the expiration of the patent, and after M. Holzapfel & Co. had commenced to make and sell said composition, and at divers subsequent times throughout the year, various attempts were made by the Rahtjen firm and their agents, Suter, Hartmann & Co., to register in England the words "Rahtjen's Composition" (and modifications of said words), but without success. Finally Suter, Hartmann & Co., by *disclaiming the exclusive right* to the use of the word

" Rahtjen's," obtained a registration in England for a certain combination of words, of which their name, Suter, Hartmann & Co. was an essential part.

In 1885 the predecessors of complainant, the Rahtjen firm and Suter, Hartman & Co., brought suit in Belgium against W. Wright, of Brussels, for putting on the sign on his house the inscription, " Manufacturers of Rahtjen's Composition," and for announcing in his prospectus and other means of publication that he sold the " Original Rahtjen's Composition for ships' bottoms, manufactured by the London Oil & Color Co., Ld." In this suit the Rahtjen firm and Suter, Hartmann & Co. were finally defeated, the Court holding, among other things, that, although Rahtjen was the inventor of the composition for ships' bottoms known by the name of Rahtjen's composition, and had given over the right to trade in that product to Suter, Hartmann & Co., yet, as his English Patent had expired, his invention had become the property of the public, and that the defendant was consequently authorized to manufacture and sell said composition under the name " Rahtjen " generally used to describe it.

In 1897 Rahtjen instituted criminal proceedings in Hamburg, Germany, against Max Holzapfel and his Hamburg agents for selling the composition as " Rahtjen's," and for circulating announcements, price lists and business letters relating to same as " Rahtjen's." The Court decided that, in view of the lapse of the English Patent, the manufacture of the paint in accordance therewith became public property, and that the defendant was entitled to make and sell it in Germany as " Rahtjen's Composition, Holzapfel's Manufacture."

The complainant company and its predecessors in interest (who are still the largest stockholders in the complainant company) have known of the use by the defendant and its predecessors in business of the word " Rahtjen " in connection with said composition manufactured by the latter ever since early in 1883.

His Honor Judge WHEELER, holding Circuit Court, dismissed the bill of complaint. The decision is reported in 97 Fed., 949, and will also be found at page 419 of the printed record in this case.

From this decision the complainant appealed. The assignment of errors filed with the appeal will be found at page 421 of the printed record.

The Circuit Court of Appeals for the Second Circuit, by a divided court, reversed the Circuit Court and ordered an injunction, but no accounting.

Judge SHIPMAN wrote the opinion, Judge LACOMBE concurring therein (pp. 427–431). Judge WALLACE wrote a dissenting opinion (pp. 432, 433).

The Holzapfel's Compositions Company, Limited, thereupon filed a petition to this Court for a *writ of certiorari*. In its petition, said Company claimed :

FIRST. That when a name under which an article has become known in the country in which it was patented, becomes public property there, by reason of the expiration of the patent, it becomes public property the world over (except in such countries where there may be valid, existing patents, on said article, unaffected by the term of the foreign patent).

SECOND. That, under the circumstances stated in the foregoing claim, the right to manufacture the article, and sell it as being made in accordance with the expired patent, has become public property and open to the entire world.

THIRD. That if the Rahtjen's Company or its predecessors ever acquired a common law trade-mark in the United States, such trade-mark became public property when the English Patent expired.

FOURTH. That the Rahtjen's Company cannot have a common law trade-mark in the United States in a name which has become public property abroad.

FIFTH. That the name "Rahtjen's Composition" has become the generic description of a patented article and passed to the public on the expiration of the patent.

SIXTH. That the name "Rahtjen's Composition" has long ceased to denote the source of manufacture.

SEVENTH. That the Rahtjen's Company and its predecessors, having stood silently by for very many years and allowed the petitioner's predecessors to build up an established business in "Rahtjen's Composition," and the business having been subsequently incorporated with a large capital and numerous new stockholders, is forever estopped from enjoining or interfering with the petitioner's use of the word "Rahtjen's."

EIGHTH. That the sale by the predecessors in business of the Rahtjen's American Composition Company was not large enough, or conducted for a long enough period in the United States, for the said company to have acquired a common-law trade-mark in the United States prior to the application for the English Patent.

NINTH. That the act of the predecessors of the Rahtjen's Co. in disclaiming the exclusive use of the word "Rahtjen" when they applied for the registration of a trade-mark in England estops them from claiming such exclusive right now in this country.

The petition was granted on May 21, 1900.

The case is now before this Court on *writ of certiorari.*

Throughout this brief, following the designation before the courts below, we shall term Rahtjen's American Composition Company the complainant and Holzapfel's Compositions Company, Limited, the defendant.

10907

I.

The question raised on the threshold of the case is whether a party can own a trade-mark here when he has lost that same trade-mark in a foreign country by the expiration of a patent of that country, owned by him on the article.

This question, so far as the reported decisions go, is a novel one.

Prior to this suit the line of decisions in this country relate only to the effect of the expiration of a United States Patent on a trade-mark used here. The law has become well settled on that point, and it has been uniformly held by our Courts that the name given to the article during the life of the patent becomes public property when the patent expires.

It was so held in the case of the "Singer Sewing Machine."

Singer Mfg. Co. vs. June Mfg. Co., 163 U. S., 169.
Singer Mfg. Co. vs. Riley, 11 Fed. Rep., 706.
Singer Mfg. Co. vs. Stanage, 6 Fed. Rep., 279.
Singer Mfg. Co. vs. Larsen, 8 Biss., 151.

And in the case of "Yale Locks."

Ex parte Yale & Towne Mfg. Co., 81 Pat. Off. Gaz., 801.

And in the case of "Fairbank's Scales."

Fairbanks vs. Jacobus, 14 Blatchf., 337.

And in the case of "Goodyear Rubber."

Goodyear India Rubber Glove Mfg. Co. vs. Goodyear Rubber Co., 128 U. S., 598.
Goodyear Rubber Co. vs. Day, 22 Fed. Rep., 44.

And in the case of " Leclanche " batteries.

Leclanche Battery Co. vs. Western Electric Co., 21 Fed. Rep., 538; 23 Fed. Rep., 276.

And in the " Castoria " cases.

Centaur Co. vs. Heinsfurter, 84 Fed. Rep., 955.

Centaur Co. vs. Killenberger, 87 Fed. Rep., 725.

Centaur Co. vs. Neathery, 91 Fed. Rep., 891.

Centaur Co. vs. Marshall, 92 Fed. Rep., 605.

And the same rule has been laid down in England.

See " Cheavin's Patent Filter Case."

Cheavin vs. Walker, Law Rep., 5 Chan. Div., 850.

And in the " Wheeler & Wilson " case.

Wheeler & Wilson Mfg. Co. vs. Shakespeare, 39 Law (N. S.) Ch., 36.

And in the " Linoleum " case.

Linoleum Mfg. Co. vs. Nairn, 47 Law J. (N. S.) 431.

But the text-books, and Federal and State decisions, may be searched in vain for any discussion or statement of the effect of the expiration of a foreign patent on a trade-mark used here, as well as abroad, by the owner of such expired patent.

The present case raises this question, and it is of great importance to the commercial community at large what the rule to be established by this Court shall be.

We contend that where a name under which an article has become known in the country in which it

was patented, becomes public property there by reason of the expiration of the patent, it becomes public property the world over, except in countries where there may be valid existing patents on said article unaffected by the term of the foreign patent, which is not the present case.

The history of "Rahtjen's" composition is a continuous one, and it cannot be considered in sections, chronologically or geographically. Everything connected with this paint from the time it was invented by Rahtjen, until the present time, bears upon the question at issue.

A bottom paint of this description, to be successful, must acquire a wide reputation and have more than a local standing.

The ship that paints with it in Liverpool may dock again in New York, or Rio de Janeiro, or San Francisco, or Hong Kong, or Genoa, and must find the same paint in such far-away ports.

A composition like this, therefore, lives its life in the whole maritime world.

It must be remembered, too, that, at the time the Rahtjen composition was patented and became known, the carrying trade of the world was done mainly by England. It was English ships, painted with this bottom paint, that made known and established a demand for it in all quarters of the world.

Thus Rahtjen's paint went around the earth and became known as a patented composition during the life of the English Patent, and when that patent expired the generic appellation by which it had been known during the life of the patent became *publici juris*, not only in England but everywhere.

The history of "Rahtjen's" composition pivots around the Rahtjen English Patent in evidence (pp. 387–393).

The sales, prior to taking out the patent, were very small and largely for experimental purposes. *

It was during the life of the patent, as will be seen from the record, that the paint became known in England and throughout the maritime world. It was during this period that the circulars, signs and business advertisements of this composition, not only in Europe, but in the United States, invariably used the word " patent " (meaning the English Patent) thus— " Rahtjen's Patent Paint."

A circular of the firm of John Rahtjen is identified by John Rahtjen and is in evidence (" Defendant's Exhibit Rahtjen Circular," Record, p. 410). This circular bears on its face the words " Rahtjen's Patent Composition, by Royal Letters Patent," accompanied by the representation of the English Royal Coat of Arms. John Rahtjen testifies that, in calling the composition " Patent Composition," he meant it was covered by the English Patent (p. 127, x-Q. 285, x-Q. 287). Rahtjen says it was " Rahtjen's Patent Composition as " long as we had a patent, and ' Rahtjen's Composi- " tion ' afterwards. During the time the patent was " in existence we used the word ' Patent,' and we " dropped it afterwards " (p. 151, Qs. 500, 501).

All of the letter-heads, bill-heads, invoices, etc., of complainant's predecessors, and their agents, until the patent was forfeited in 1880, contained the words

---

* Rahtjen's testimony regarding shipments to Gelien in the United States do not agree with the latter's testimony.

	1870.	1871.	1872.
Rahtjen testifies that his shipments to Gelien were (p. 139, Q. 373)	$82	$2,217	$2,074
Gelien testifies that his shipments from Rahtjen were (p. 167, x-Qs. 23-25).....	None	$2,432	$829

"Rahtjen's Patent Composition." This was so in *England* (see "Suter, Hartman & Co's. Invoices, 1877, 1878 and 1879," p. 394; "Rahtjen's Advice Notes, 1878 and 1879," p. 395; "Exhibit V," p. 192; "Exhibit W," pp. 192, 193; "Exhibit JJ," p. 198), and also in the *United States* ("Exhibit T," p. 190; "Exhibit U," pp. 191, 192).

A number of witnesses also testified that it was always reputed and represented to be made under a patent (p. 297, Q. 67; p. 313, Q. 11; p. 344, Q. 10; p. 351, Q. 11; p. 348, x-Q. 63; p. 348, x-Q. 71), and that it was the patent that gave it its value.

We thus see the stress that was laid upon this English Patent during its life by the makers and sellers of the Rahtjen composition.

The English Patent was forfeited, revoked and canceled upon the failure to pay the tax imposed on it, at the end of the first seven years, to wit—on November 29th, 1880 (pp. 393, 394).

Thereupon the right to manufacture it in England became public property. The right to manufacture it elsewhere had always been public property, because nowhere, except in England, had it ever been protected by patent.

But more than this: Not only could any person, after the forfeiture of the English Patent in 1880, make this Rahtjen's composition in England and elsewhere, but he could also sell it. And sell it under what name? Why, under the name, and the only name, it was known by during the life of the English Patent. During the life of that patent the paint became *generically* known as "Rahtjen's." The maritime world knew it as "Rahtjen's." That was its generic description throughout the world. And if, after the expiration of that patent, one wanted that product or paint, he could ask for it by no other name. And the manufacturers could sell it under no other name. The property in the name could no more survive here than

it could in England and abroad after the expiration of the English Patent.

When an invention falls into the public domain it enters with the name which the inventor has given it. The ex-patentee cannot have a trade-mark in this country in a name for a maritime article which is common property everywhere else. If he or his representatives desire to continue the manufacture of the article after the expiration of the patent and desire to protect his or their reputation as manufacturers thereof, he or they must adopt a new and arbitrary trade-mark, and build up the rights of ownership therein exactly as would a stranger.

This contention, while opposed to the opinion rendered herein by Judge SHIPMAN, is supported as follows :

1. By the dissenting opinion of Judge WALLACE, in the Circuit Court of Appeals.
2. By the opinion of Judge WHEELER, sitting at Circuit.
3. By the decision of the Belgian Court of Appeals.
4. By the decision of the Criminal Court in Hamburg.

We shall take these decisions up in the following order :

The Belgian Decision. From the facts stated in this decision, it appears that in 1885 Rahtjen and Suter, Hartmann & Co. (the predecessors of Rahtjen's American Composition Co.), brought suit in Belgium against W. Wright, the agent of the London Oil and Color Co., for putting on the sign of his house the inscription, " Manufacturers of Rahtjen's Composition," and for announcing that he sold " Original Rahtjen's Compositions for Ships' Bottoms, manufactured by the London Oil and Color Co., Limited." It appeared that Rahtjen, the inventor of the paint and the prede-

cessor of the complainant, had patented the article in England, in 1873, and that this patent was forfeited in 1880. During its life, however, the article had become known in the maritime world under the generic name, "Rahtjen's Composition." On the expiration of the patent in England, the London Oil & Color Co., Limited, made the paint in England and shipped it to Wright to be sold in Belgium under the name "Rahtjen's Composition." The complainants then commenced this action to restrain the unlawful use of the word "Rahtjen." The Brussels Court of Appeals, in reversing a judgment in favor of the complainants, held: (1) That when the English Patent expired any person could make the product in England, calling it Rahtjen's Composition, and that the product so made could be shipped to Belgium and sold there; (2) That any person who could make the article in England and sell it Belgium could call it in Belgium by the name it had acquired during the life of the English Patent (pp. 358-360).

The German decision. From the statement of facts in this decision it appears that in 1897 John Rahtjen instituted criminal proceedings in Hamburg, Germany, against Max Holzapfel and his Hamburg agents, Joost & Schultz, for marking the composition and also the announcements, price-lists, business letters, &c., with the name of "Rahtjen." The facts in the case are very fully stated in the opinion, wherein the fact that Rahtjen was the inventor of the composition, and had sold it for a considerable period under his own name; that on November 29, 1873, he obtained a patent in England for the paint under the title "Preservative Composition for Ships' Bottoms, &c.," but that, owing to failure to pay the tax under the English Patent Law, the patent lapsed, is fully recited, and the Court said, "The manufacture of the paint in accordance with the patent therefore became public property."

The substance of the decision is that the words "Rahtjen's Patent" Composition conveys to any interested party no other meaning than that the composition recommended was manufactured in accordance with Rahtjen's Patent. That it could possibly be a preparation of Rahtjen himself, this form of expression was not likely to suggest to any person belonging to the class among whom such goods were sold. The assumption that the goods recommended were supplied from Johann Rahtjen's works was further refuted by the fact that the Holzapfel's Company expressly called itself "Manufacturers of Genuine Rahtjen's Patent Paint," and added, "Warranted made according to Rahtjen's original specification." This addition removed any doubt as to the goods offered not being Rahtjen's manufacture. Besides, this addition was conformable to the truth. The witness Rahtjen himself admitted that the defendant Max Holzapfel doubtless manufactured the paint according to the original patented receipt of his (Rahtjen's) father, which he had found in the specification. Besides, the defendant Max Holzapfel had been most energetic to remove any doubt as to his company being the manufacturer of "Rahtjen's Patent" composition, for he actually referred to their own trade-mark and recommended customers to specially ask for "Holzapfel's" manufacture. Where, therefore, the name of "Rahtjen" was so used, the possibility of that portion of the public which might be desirous of purchasing goods of this kind being misled as to the origin of the goods was out of the question (pp. 364, 365).

Judge WALLACE'S *opinion.* Judge WALLACE says: "I "am of the opinion that the alleged trade-mark of the "complainant is public property—first, because the "name was the generic description of a *patented* arti- "cle, and passed to the public upon the *expiration of* "*the patent.*" He then recites the facts in the present case, and, after dwelling on the Belgian decision, says:

"I am at a loss to understand why any different de-
"cision should be made in this country, but the Court
"seems to be of opinion that the name is a good
"trade-mark here, because no patent was ever ob-
"tained for the article in this country, and because
"the successors in business of Rahtjen have always
"sold it here under the name originally applied to it.
"This means that a man can have a trade-mark in this
"country in a name which is common property every-
"where else. If this is good law, then any person
"here buying in Belgium, or elsewhere in Europe, or
"in England, the article known as Rahtjen's composi-
"tion, can be prevented from dealing in it here under
"the name by which he bought it. So long as Rahtjen
"and his associates and successors in business en-
"joyed a monopoly of the manufacture of the article,
"the name not only identified the characteristics of
"the article, but also denoted the source of manufacture;
"but when the monoply ceased, and the article passed
"into the domain of public property, the name which
"had been its generic designation also passed. Their
"monopoly has ceased to exist in this country as well
"as abroad, and *the property in the name can no more*
"*survive here than it can abroad*" (pp. 432–433).

Judge WHEELER'S *Decision.* Judge WHEELER, sitting at circuit, in dismissing the bill, said: "Rahtjen's com-
"position appears to have become a valuable article of
"commerce, well known by that name throughout the
"maritime world, through Rahtjen's expired English
"patent and his operations under it, so that his name
"in connection with trade in that product is descrip-
"tive of it and not an indication of its origin as from
"him or under his right. The article advertised for by
"the Government in calling for the bids which are
"claimed to be an infringement or unfair in competi-
"tion was this product, however produced, and not the
"product produced by or under him. To bid for fur-
"nishing such a well-known article, by whatever name

" known that would describe it, would not seem to be " actionable according to any established principles of " law " (p. 419).

The complainant, surely, cannot have a trade-mark in this country in a name which is common property everywhere else.

Nor does the Scotch case of Singer Mfg. Co. vs. Kimball, referred to in Judge WHITE'S opinion in Singer Mfg. Co. vs. June Mfg. Co., conflict with the doctrine laid down in the Belgian and German cases, and the opinions of Judges WALLACE and WHEELER, above referred to. That Scotch case which supported the alleged trade-mark in the word " Singer " for a sewing machine, did so *under the belief that the Singer machine was never patented anywhere, and that there was no generic principle which might be termed the Singer principle shown in those machines.*

We quote from the Lord President's opinion in said Scotch case :

" Now, it appears to me that for a series of years, " and certainly, I think, back to the year 1863, as " averred in the petition, everybody in the trade has " understood that a Singer Machine or a Singer Sew- " ing Machine is a sewing Machine manfactured by " the Singer Manufacturing Company. I think that is " the fair result of the evidence. It has hardly been " denied that for that period the fact has been so. But " then reference is made to an earlier period in the " history of the use of this word, as showing that the " meaning thus acquired by the word Singer arose " from false representation made by Mr. Singer and " afterwards by the Singer Manufacturing Company, " or some other Company that preceded them, as to " the right of Mr. Singer, as having a patent or " patents, which enabled him, for a time, at least, ex- " clusively to manufacture what was called the Singer " Machine. Now, no doubt Mr. Isaac Singer, who " appears to be still a partner of this Company, so far

" back as 1852, was under the impression that he had " made an original invention, and he expected to obtain " a patent for it, but in that he was disappointed. It " turned out that the straight needle with the vertical " action, which he conceived to be a novelty invented " by himself, had been anticipated in other Sewing " Machines, and the consequence was that he did not " obtain a patent for that.

" But I am not prepared to say that there is any " evidence in this case to show that either Mr. Singer " or any person associated with him in business com- " mitted any fraud in the way of holding out to the " public that they held patents which they did not " hold. I do not think there is sufficient evidence of " that, or that the use of the word Singer, as appli- " cable to machines made by him and his company, was " caused by their false representations of patent rights " belonging to him. On the contrary, it rather ap- " pears to me the use of the name grew up and ma- " tured just in consequence of Mr. Singer and those " connected with him in business having constantly " gone on making this kind of machine which he " thought originally was a novelty, and improving it in " every kind of way that occurred to them in the " progress of their business. It was in that way, I ap- " prehend, that the name 'Singer' came to have what " is now its established meaning, and I cannot see that " there is anything in the history of that appropriation " of the name to prevent the Singer Manufacturing " Company now from asserting right to it as their " trade-mark. It is said, no doubt, on the part of the " defendant, that to interdict him and all other manu- " facturers of sewing machines from the use of this " name involves a great hardship, *because they cannot* " *otherwise describe what they are perfectly entitled to* " *make in their business, machines upon the Singer prin-* " *ciple.* Now, that statement at first sight is very " plausible, but it seems to me to rest upon a fallacy. " *It assumes that there is* what is called a Singer prin-

" ciple—that is to say, that there are some peculiar-
" ities in the machines made by the Singer Manufact-
" uring Company that are not to be found in any
" other machines, or some combination of these
" peculiarities that is not to be found in other ma-
" chines, and it would be very desirable to ascertain
" precisely what that is before disposing of the argu-
" ment founded upon these assumptions. But I con-
" fess I have looked in vain in the proof for anything
" like a definite or intelligible explanation of what is
" meant by the Singer principle."

(1873) Singer Mfg. Co. vs. Kimball, 11 Cases Ct. of Session, 3 Series, p. 267 (272-3).

The counsel for complainant have insisted that the English or foreign history of the trade-mark should not be considered in this case. Yet the foreign history and status of a trade-mark claimed in this country has been considered by our courts. It was so considered by this Court in the "Hunyadi" cases recently decided.

> In the "Hunyadi" cases, decided last October, this Court considered the *foreign* history of the trade-mark: Saxlehner's discovery of the spring, in 1862; his obtaining permission from the Hungarian authorities, in 1863, to give it the name of Hunyadi Spring; his carrying on an uninterrupted trade under that name until 1872; his registering in Hungary, in 1872, the trade-mark "Hunyadi Janos;" his protest against the grant to Ignatius Markus, to use "Hunyadi Matyas," as a trade-mark for other water, in which he was first successful, but finally defeated; the opening of other springs by competitors under trade-marks of which the words "Hunyadi" formed part; his instituting an unsuccessful suit in Hungary, in 1887, against the use of the words "Hunyadi Josef;" his registration of his labels under the Hungarian law of 1890; and his instituting suits in the following year

against all infringers in Hungary, which finally resulted in the establishment of Saxlehner's right to the name "Hunyadi;"—all these facts were proven in the case, and were considered by this Court, and are recited in its opinion.

It is clear, this Court said, "that the word "became and continued to be for twenty years "public property *in the Kingdom of Hungary*, and "it is difficult to escape the conclusion that it "became so here."

(1900) Saxlehner vs. Eisner & Mendelson Co., 179 U. S., 19.

In Dadirrian vs. Yacubian, the Circuit Court of Appeals for the First Circuit went fully into the foreign history of the word claimed here as a trade-mark. The complainant below had registered the word "Matzoon" as a trade-mark in this country. It appeared conclusively that complainant had remained within the United States in the exclusive and undisturbed possession and use of the alleged trade-mark for about seven years, and that he had in that time not only enjoyed an extensive and valuable trade in connection therewith, but that he had created it so far as this country was concerned. The Court admitted that the facts of the case made a very strong *prima facie* case for the complainant, "so that neither justice to him nor the interests of the public will permit the denial of the relief which he asks, unless legal principles clearly require it." The defense was that the complainant's article of merchandise was a historically and locally well known Armenian healthful beverage, containing certain medicinal qualities of which "Matzoon," or more properly "Madzoon," was the proper Armenian descriptive word.

The Court held that a word which is the common name of an article *in Armenia*, could not be

appropriated as a trade-mark or trade-name by the person who introduced the article and the name into this country.

(1900) Dadirrian vs. Yacubian, 98 Fed. Rep., 872; affirming S. C., 90 Fed. Rep., 812. See, also, case on motion for preliminary injunction, 72 Fed. Rep., 1010.

The complainant contends that its predecessors acquired a common law trade-mark in this country before making the application for the English Patent.

We know of no rule of law laid down in the text books or in the decisions in this country, on this point.

Centaur vs. Heinsfurter. In the case of Centaur vs. Heinsfurter it would seem that the point was raised by the pleadings whether a man having acquired a common law trade-mark prior to the grant of a patent on the article, could not still retain his trade-mark rights after the expiration of a patent. From the statement of facts printed at the head of the case it would appear that, *prior to 1868*, one Pitcher, the predecessor of the complainant *invented* a medicinal compound *and sold* it under the name of "Castoria." *In 1868* he obtained a patent on the formula. After the patent expired the defendant manufactured the article in accordance with the formula, and sold it as "Castoria." The complainant filed a bill asking that the defendant be enjoined from selling its goods under the name of "Castoria." The Court ignored the point raised by the allegation of the acquisition of a common-law trade-mark prior to the grant of a patent, and decided that when the patent expired the right to make the article and to sell it as "Castoria" was open to the world (Centaur Co. vs. Heinsfurter, 84 Fed. Rep., 955).

Batcheller vs. Thomson—The respondent, in their brief below, cited Batcheller vs. Thomson, 93 Fed. Rep., 660, as supporting its contention that, if its predecessors used said trade-mark two and one-half years prior to obtaining the patent, the subsequent expiration of the patent would not affect the trade-mark

rights. That case, however, we submit, does not bear out that contention. The facts of that case are stated by the Court in its opinion: "When Thomson commenced, in Paris and in England, the manufacture of "corsets, they were made in accordance with an alleged "invention of Edward Drucker. Letters Patent of the "United States for this corset were issued in the name "of Drucker on May 7, 1867, but the corsets made "accordingly were unsatisfactory; the alleged inven-"tion was concededly of no value, ceased to be used, "and an improvement was made in England by an "employee of Thomson, which was patented in the "United States on November 30, 1869, to Henry A. "Lyman, assignor to Thomson, Langdon & Co. This "patent expired November 30, 1886. How closely the "corsets of complainant or defendant followed this "improvement did not appear, and, indeed, the dis-"tinctive value which the improvement imparted to "the product did not appear" (see middle p. 663). * * * "The Thomson corset was extensively ad-"vertised, and was a favorite, but whether its value "was connected with the Lyman Patent is unknown" (p. 665). *These facts are very different from those of the case under consideration, where we have an article of intrinsic merit, made under a patented formula, and deriving its value from the formula, and not from the name.*

Upon the above facts the complainant has no trademark in the word "Rahtjen's" and the bill of complaint should be dismissed.

II.

The act of the predecessors of the complainant in disclaiming the exclusive use of the word "Rahtjen" when they applied for the registration of a trade-mark in England, estops complainant from claiming such exclusive right now in this country.

Bearing in mind the forfeiture of the English Patent for Rahtjen's Composition in 1880, and the fact that the name "Rahtjen's Composition" had become public property, we now call attention to the following efforts made by the complainant's predecessors to secure a trade-mark in England:

(1) On June 25, 1883, John Rahtjen filed an application for registration of the words "*Genuine Rahtjen's Composition for Ships' Bottoms*, &c." (Defendant's Exhibit, Cert. Copy Record of Application, Opposition, and Withdrawal of John Rahtjen, No. 32,826 of 1883," pp. 400–402). This was after the English Patent to Rahtjen had been forfeited and after the defendant's predecessors had commenced to make and sell (May, 1883) "Rahtjen's Composition, Holzapfel's Manufacture." M. Holzapfel & Co., through their solicitors, filed a written notice of opposition to the registration sought (p. 401). Rahtjen filed no counter statement, and his application was held to be withdrawn and abandoned (p. 402).

(2) On July 7, 1883, John Rahtjen filed an application for registration of the words "*Rahtjen's Composition*" (Defendant's Exhibit, Cert. Copy Record of the Application, Opposition, and Withdrawal of John Rahtjen, No. 32,951 of

1883," pp. 397–399). This was after said English Patent had been forfeited and after the defendant's predecessors had commenced to make and sell "Rahtjen's Composition, Holzapfels Manufacture." M. Holzapfel & Co., through their solicitors, filed a written notice of opposition to the registration sought (p. 398). Rahtjen filed no counter-statement, and his application was held to be withdrawn and abandoned (p. 399).

(3) On June 28, 1883, Suter, Hartmann & Co., filed an application for registration of the words "*Rahtjen's Patent Composition*, for Ships' Bottoms, Buoys, &c. None genuine without this signature. Suter, Hartmann & Co." ("Defendant's Exhibit, Cert. Copy Application, Opposition, and Withdrawal of Suter, Hartmann & Co., No. 32,858, of 1883," pp. 402–405). This was after the English Patent to Rahtjen had been forfeited, and after the defendant's predecessors had commenced to make and sell "Rahtjen's Composition, Holzapfel's Manufacture." M. Holzapfel & Co., through their solicitors, filed a written notice of opposition to the registration sought (p. 403). Suter, Hartmann & Co. filed no counter statement, and their application was held to be withdrawn and abandoned (p. 404.)

(4) On January 9, 1884, Suter, Hartmann & Co., filed an application for registration of the words "Rahtjen's Patent Composition for Ships' Bottoms, Buoys, &c. Directions. Suter, Hartmann & Co." ("Defendant's Exhibit Cert. Copy, Suter, Hartmann & Co.'s Application for Trade-mark 39,919 of 1884," pp. 406–407); and in their application appears this disclaimer: "*We do not claim the exclusive use of the words 'Rahtjen's Patent Composition for Ships' Bottoms, Buoys, etc. Directions,' or any of such words, except as part of the combination constituting our trade-mark, as represented annexed, and to which we claim exclusive right*"

This is a *full disclaimer of any exclusive right to the words "Rahtjen's Patent Composition,"* or any of those words except when accompanied by all of the other words above quoted; and the defendant has never used said combination of words.

Where the plaintiff has disclaimed the exclusive use of "W. R." as a trade-mark, to be stamped on goods, held, that he could not restrain the defendant from using the letters "W. R." on the same class of goods.

(1892) Rosenthal vs. Reynolds, 61 L. J. Ch., 508.

So, when the applicant for registration of a trade-mark, restricted himself in his application to a *red* anchor, the Court refused to recognize his claim to the unlimited use of the anchor emblem. The Court said: "He thereby gave public notice to all traders and others in the United States, that he adopted as his trade-mark for medical compounds, not the representation of an anchor generally, but a red anchor in a white oval space or field. This limited registration was a very deliberate act of the plaintiff, and he must abide the consequences. It would be a perversion of the right of registration under the Act of Congress, of which the plaintiff availed himself, and would amount to a fraud on other traders to permit the plaintiff now to *assert broader rights* in the anchor as a trade-mark symbol than his public registration in 1885 disclosed."

(1892) Richter vs. The Anchor Remedy Co., 52 Fed., 455.

III.

The name "Rahtjen's Composition" has long ceased to denote the source of manufacture, and has become the generic description of the article.

The Complainant Company has always been particular to give prominence to, and has always advertised, that the "Rahtjen's Composition" sold by it was of "Hartmann's Manufacture," and that the said goods were to be distinguished from those manufactured by others not by the words "Rahtjen's Composition," but by the "Red Hand" brand (pp. 410–412).

The evidence shows that said company always sold said composition as "Hartman's Rahtjen's" or "Hartmann's Manufacture" (p. 21, x-Q. 60). And the drums in which it was sold bore the representation of a "*Red Hand*" with the words "Trade" on one side and "Mark" on the other side thereof.

Had complainant and its predecessors relied upon their alleged right to the exclusive use of the word "Rahtjen's" as a trade-mark or trade-name, which protected said composition of their manufacture, they would not have taken out the "Red Hand" trade-mark, nor would they have affixed the words "Hartman's Manufacture" (for why should the manufacturer identify his name with it, if there was only one, and could be only one, Rahtjen's Composition?), nor would they have disclaimed the exclusive right to the word "Rahtjen's" in their application for English registered trade-mark No. 32,194 (p. 408).

The testimony in this case, of disinterested witnesses, familiar with maritime matters, is to the effect that the maritime world understood "Rahtjen's Composition" to be a *kind* of paint, and not the paint of any particular source of manufacture (see testimony of Schnitger, p. 297, Q. 67; Nicholl, p. 313, Q. 11; Howden, p. 344, Q. 10; Stephens, p. 351, Q. 11).

The Belgian decision (p. 358) held that the name "Rahtjen" had long ceased to denote the source of manufacture.

The German decision (pp. 364, 372) held likewise.

There are two exhibits in this case, to which particular attention is called, as showing that both the English and the United States Governments, respectively, in calling for supplies of Rahtjen's Composition, *recognize it not only as a generic thing, but as having a widely-known common formula, by whomsoever manufactured.* These exhibits to which we refer, are the letter from the Royal India Office (pp. 416, 417) and the U. S. Government proposal for bids (p. 18) and U. S. Government Requisition (p. 51).

In the letter from the Royal India Office, the defendant company is informed that its name has been placed on the *list of contractors* to that department for the supply of Rahtjen's composition. It was also notified that it would be required to supply it in *accordance with the departmental standard* (p. 417, 418).

In the U. S. Government proposals and requisitions, the contractors are notified that the "Rahtjen's" to be furnished is *subject to usual inspection* at the navy yard (p. 51).

Furthermore, that the paint became known under a generic designation, and had no reference to the source of manufacture, is shown by the action of the complainant in this case in printing and painting on and about its goods the words "Hartmann's Manufacture" (p. 52*a*, 52*b*), thus unqualifiedly recognizing that there were different manufacturers and sources of the generic thing known as "Rahtjen's Composition."

As was said, in deciding this case, by the learned Judge at Circuit:

> "Rahtjen's composition appears to have become
> "a valuable article of commerce, well-known by

" that name throughout the maritime world,
" through Rahtjen's expired English Patent and
" his operations under it, so that his name in con-
" nection with trade in that product is *descriptive*
" *of it*, and not an indication of its origin as from
" him, or under his right. The article advertised
" for by the Government, in calling for the bids
" which are claimed to be an infringement or un-
" fair in competition, was this product, however
" produced, and not the product produced by or
" under him. To bid for furnishing such a well-
" known article, by whatever name known that
" would describe it, would not seem to be action-
" able according to any established principles of
" law " (p. 419).

And Judge WALLACE, writing the dissenting opinion in the Circuit Court of Appeals, says *(inter alia)* :

" Irrespective of the effect of the patent, the
" designation has become *publici juris* through its
" long use by dealers in the article which it de-
" scribes, and whether this is attributable to the
" acquiescence of the complainant and its prede-
" cessors, or to their laches, is immaterial, since
" their conduct, active or passive, has led to the
" result.

" One test by which to determine whether a
" word which was originally a trade-mark has be-
" come *publici juris* is whether the use of it by
" persons other than the original owner is still
" calculated to mislead the public and induce them
" to buy goods not made by the original owner, upon
" the supposition that they are his goods. When-
" ever the same has come to be so generally un-
" derstood by the public dealing in the article, as
" denoting the article itself that nobody can be
" deceived, by the use of it, into the belief that
" it was made by any particular person, the right

" to it as a trade-mark is gone (Ford v. Foster,
" L. R., 7 Ch. App., 611). If that test is applied
" to this case, there can be no doubt the name is
" no longer a valid trade-mark " (p. 433).

In the case of the Elgin National Watch Co. vs. Illinois Watch Co., this Court, speaking of a trade-mark, said :

" The term has been in use from a very early
" date, and, generally speaking, means a distinc-
" tive mark of authenticity, through which
" the product of *particular manufacturers*, or the
" vendible commodities of *particular* merchants,
" may be distinguished from those of others."

(1901) Elgin National Watch Co. vs. Illinois Watch Co., 179 U. S., 665 (673).

In the recent controversy over the use of the words " The Edison Phonograph Agency," the U. S. Circuit Court for the Eastern District of Pennsylvania held that the word " Edison," as applied to phonographs, was merely *descriptive* of the article, and meant only that the phonograph was invented by Edison.

(1901) Edison vs. Hawthorne, 106 Fed. Rep., 172.

" Rahtjen," then, has long ceased to denote the source of manufacture of this paint, or to indicate the name of the vendor, and has become merely the generic description of the article itself.

IV.

There has been no unfair competition.

The case is quite clear from all wrongful intent, or wrongful imitation or simulation, or deception of the public.

Rahtjen's composition, Judge WHEELER held, "became a valuable article of commerce, well known by that name throughout the maritime world through Rahtjen's expired English Patent and his operations under it, so that his name in connection with trade in that product is descriptive of it and not an indication of its origin as from him or under his right" (p. 419). That being so, the defendant had the right to use the name "Rahtjen's Composition," provided it did not represent it to be the manufacture of some other person or company. This it has always conscientiously avoided.

The defendant and its predecessors in interest have always taken special pride in representing that the composition in question was *their manufacture*. They have invariably used their *own name* as manufacturers of it, in connection with it. Special attention is called to "Defendant's Exhibit Holzapfel & Co.'s Circulars, Advertisements, Letter Heads, etc." (extracts from which are printed on pp. 414–416), and also to the "Defendant's Agents' Letter Heads, Estimate Blanks, Advertisements, Cards, etc." (printed on pp. 417–419), in which invariably the composition is expressly stated to be *made according to the patent*, or else by the words "Rahtjen's Patent" Composition (the first two words in quotation marks, which, as the Brussels Court held, conveyed no other meaning than that the composition recommended was manufactured in accordance with "Rahtjen's Patent").

In addition, the markings on the drums in evidence show the importance the defendant places on its own name as manufacturer.

In addition, the defendant marks said composition with its own trade-mark of a red propeller.

The receipted bill ("Complainant's Exhibit Defendants' Bill," p. 52) for the composition purchased by complainant of the defendant, and on which the suit is brought, shows the red propeller, and describes the article sold as the defendant's manufacture.

And both the Circuit Court and the Circuit Court of Appeals have decided there was no unfair competition on the part of the defendant.

V.

The complainant having stood silently by for very many years and allowed the defendant's predecessors to build up an established business in "Rahtjen's Composition," and the business having been subsequently incorporated with a large capital and numerous stockholders, is forever estopped from enjoining or interfering with the petitioner's use of the word "Rahtjen's."

This is not a case of *actual fraud* in which the doctrine of laches has but an imperfect application. The defendant throughout has acted in good faith, and under its legal rights as it understands them. There has been no imitation of labels and no unfair competition in trade. Everything the defendant has done has been done openly and in good faith.

The complainant and its predecessors in business have known for the past sixteen years that the defendant and its predecessors in business were making and selling openly and notoriously a composition for ships' bottoms under a name of which the word "Rahtjen" formed part. This was well known to the founders and directors of the English or parent company, from whom the complainant company derives its rights (if any), and who are also directors and owners of the majority of the capital stock in the complainant company.

The defendant and its predecessors have continuously, since 1883, advertised its Rahtjen's composition extensively, and have spent from £1,500 to £1,800 for such purpose annually (p. 269, Q. 69), and built up an active competition with the complainant and its predecessors, and finally outstripped them. The testimony is undisputed that the defendant's business in these composition paints for ships' bottoms is to-day larger than that of any other company of the like nature in the world (p. 280, Q. 157; p. 331, Q. 63; p. 332, x-Qs. 68, 69).

Thus, from 1883 to the present time, the defendant or its predecessors, *acting in good faith* and on what we submit was its legal rights, has been continuously, openly and notoriously supplying quantities of "*Holzapfel's* Rahtjen's Composition" in England, in Europe and abroad, and in the United States. During that time its business in these paints has grown until now it is the largest one of its kind in the world. During that time from a partnership it has grown into a large and wealthy corporation, with many new parties in this country and abroad interested therein as stockholders, and the value of its property, of which the paint in question forms part, has, owing to its exertions and expenditure of money in advertising and pushing the same, immensely increased. During all this period of 16 years the complainant and its predecessors, with full knowledge of the facts, stood silently by without any assertion of its alleged rights and without even a notice or protest to the defendant.

John Rahtjen admits that he was aware, at the time he applied for a registration of his alleged trade-mark in England, in 1883 (which application was successfully opposed by defendant's predecessors), that defendant's predecessors were then using on their paint the alleged trade-mark or trade-name in question (p. 143, x-Qs. 401-404), and that defendant's predecessors and defendant have since continued to do so.

WILLIAM HARTMANN, of Suter, Hartmann & Co. (predecessors of complainant), also knew of such use. He says he knew of it soon after Holzapfel & Co. had commenced business (p. 68, x-Qs. 135–137). He was shown the circular of M. Holzapfel & Co., dated April 17th, 1883 (Defendant's Exhibit Holzapfel & Co.'s Circulars, Advertisements, Letter Heads, &c.) in which Holzapfel & Co. announce that they are making and selling a Rahtjen composition, according to the specification of the Rahtjen Patent, and he says he saw that notice about the time it bears date; to wit, April 17, 1883 (p. 81, x-Qs. 288½ and 289). Moreover, it is matter of record that the 1883 application of his firm of Suter, Hartmann & Co., for registrations of said alleged trade-marks was successfully opposed and defeated by Holzapfel & Co., the defendant's predecessors.

Suter, Hartmann & Co. were afterwards turned into the Suter, Hartmann and Rahtjen's Composition Company. This company is largely interested in the Rahtjen's American Composition Company (the complainant), the latter being an offshoot of the parent company in England (p. 81, x-Q. 290). These predecessors of the complainant in the ownership of the alleged trade-mark were also its predecessors, in the business it is now carrying on. The sixteen years' laches in England of its predecessors is, therefore, pertinent in the case. The complainant took said alleged trade-mark by assignment from assignors, who had for sixteen years been guilty of laches in the assertion of their alleged monopoly. The complainant stands in the place of such predecessors, and took the assignment of the alleged trade-mark, subject to legal consequences of the assignors' laches for sixteen years.

The defendant and its predecessors sold "Rahtjen's Composition, Holzapfel's Manufacture," in the United States continuously ever since they began in 1883 to make and sell it in England. At this long interval of time it has been impossible to get competent evidence

of the first knowledge of the agents in this country of complainant's predecessors.

But, Clark, a witness for the complainant, who was called to prove that his deceased father was agent in New York City from 1886 to 1888, inclusive, for the Rahtjen's composition of complainant's predecessors, and that he (the witness) was in such agent's employ at that time, says that he knew Donald & Co. to be the agents in New York City of Holzapfel's Rahtjen's Composition twelve or thirteen years ago (p. 163, Qs. 22, 24). He had a conversation with Donald about it, and it was cross-examined as follows:

"Re-x-Q. 32. When Mr. Donald solicited you to buy "the Rahtjen's Composition made by Holzapfel, was "not what he told you as follows: That it was made "according to the same formula as the Rahtjen's Com- "position, which you were familiar with?

"Same objection as to x-Qs. 20, 21, 23 and 24.

"A. Yes, sir; that was his idea of it.

"Re-x-Q. 33. You knew at the time, did you not, "that the Rahtjen's Composition, Holzapfel's Manu- "facture, which Mr. Donald solicited you to buy, was "not made by the same firm or manufacturer who "made the Rahtjen's Composition with which you were "familiar?

"Same objection.

"A. Well, being different firms, no; I never thought "it was the same people who were manufacturing the "paint.

"Re-x-Q. 34. And you did not intend in your testi- "mony to be understood that Mr. Donald represented "to you that it was the same people who were making "the paint?

"A. No; the same formula.

"Re-x-Q. 35. You knew then that there were two "rival establishments making the paint, but understood "that the paint made by both were from the same "formula?

" A. Mr. Donald gave me to understand that " (p. 164, Re-x-Qs. 32–35).

Various other witnesses in the United States have testified to the continuous competion for orders for Rahtjen's composition, between the defendant and the complainant, and it was well known in the shipping circles of this city for twelve years past that there were two Rahtjen's compositions for sale, viz., *Hartmann & Co.'s* Rahtjen (for sale by Petersen) and *Holzapfel's* Rahtjen (for sale by Donald & Co.).

See testimony of:

Coverly, a clerk in the office of Henderson Bros. (p. 244, Qs. 8–10).

Haffner, chief clerk for Bowring & Archibald (p. 247, Qs. 11–19).

Orington Linnekin, superintendent of the New York Dry Dock and Repair Co., East River, N. Y. (p. 249, Qs. 8–14).

Oswald Miller, superintendent for R. W. Cameron & Co. (p. 255, Qs. 11–13 ; p. 256, x-Qs. 22–27).

John Adair, superintendent of the Tweedy Trading Co. (p. 251, Qs. 11–16 ; p. 252, Q. 21). Adair also knew of the Rahtjen Composition made by Holzapfel's in England years ago.

" Q. 28. You can state any prior instance to the " painting of the ' Aguan,' where you have had per- " sonal dealing or transaction with Rahtjen's Compo- " sition, Holzapfel's Manufacture ?

" A. I had it put on a steamer at Newcastle, Eng- " land, about thirteen years ago ; thirteen to fourteen ; " I am not sure as to the date.

" Q. 29. Do you mean that you had a steamer " painted with it at Newcastle, England ?

" A. Yes.

" Q. 30. Do you remember the name of the steamer?

" A. ' Totomo Maru.'

" Q. 31. Do you remember any other instances " when you had any dealing in Rahtjen's composition, " Holzapfel's Manufacture ?

"A. Yes.

"Q. 32. You may state what?

"A. At the same time I took out a consignment to "Japan.

"Q. 33. You mean a consignment of Rahtjen's "Composition, Holzapfel's manufacture?

"A. Yes.

"Q. 34. What did you do with the consignment "when you arrived in Japan?

"A. Sold it to the Japanese Government" (p. 253, Qs. 28-34).

Mr. Andresen, assistant manager of defendant's office in New York City, cites an instance to show that Mr. Petersen, the agent for the complainant's predecessors (and the now president of the complainant corporation), knew that Donald & Co. were selling "Rahtjen's Composition, Holzapfel's Manufacture," at least as early as 1891 (p. 217). Mr. Petersen himself admits that he knew Donald & Co. were advertising "Rahtjen's Composition, Holzapfel's Manufacture," at least as early as 1892 or 1893, and that his company made no objection or protest (p. 29, x-Qs. 140-145). He saw their advertisement in the "Maritime Register" in 1893 (p. 36, x-Q. 209). He also heard rumors from abroad, and from his own agents, that defendant's Rahtjen paint was offered in the market (p. 37, x-Q. 227), and that he had in mind the defendant company when he issued the circular in 1893 (p. 39, x-Q. 246).

Was this "easy indifference" of the complainant and its predecessors commendable? Was not the course of conduct of the complainant and its predecessors during these 16 years directly to encourage the defendant and its predecessors in the use of the alleged trade-mark? Is the complainant at this late day, and in view of the changes which the lapse of time has wrought, entitled to any relief in this Court? Such undue and unexplained delay under the circumstances, we respectfully submit, renders it inequitable to grant an injunction.

The cases are many in which this defense of laches has been invoked and considered. It is true that by reason of their difference in facts, no one case becomes an exact precedent for another, yet a uniform principle pervades them all. They proceed on the assumption that the party to whom laches is imputed has knowledge of his rights, and an ample opportunity to establish them in the proper form ; that, by reason of his delay, the adverse party has good reason to believe that the alleged rights are worthless, or have been abandoned, and that, because of the change in condition during this period of delay, it would be an injustice to the adverse party if the stale claim were now permitted to be enforced.

In Mackall vs. Casilear, 137 U. S., 556, this Court said :

> " The doctrine of laches is based upon grounds
> " of public policy which requires for the peace of
> " society the discouragement of stale demands.
> " And where the difficulty of doing entire jus-
> " tice by reason of the death of the princi-
> " pal witness or witnesses, or from the origi-
> " nal transaction having become obscured by
> " time, is attributed to gross negligence or
> " deliberate delay, a court of equity will not aid a
> " party whose application is thus destitute of
> " conscience, good faith and reasonable diligence."

In Hammond vs. Hopkins, 143 U. S., 224, 250, this Court said :

> " No rule of law is better settled than that a
> " court of equity will not aid a party whose appli-
> " cation is destitute of conscience, good faith and
> " reasonable diligence, but will discourage stale
> " demands, for the peace of society, by refusing to
> " interfere where there have been gross laches in
> " prosecuting rights, or where long acquiescence
> " in the assertion of adverse rights has occurred."

In Abraham vs. Ordway, 158 U. S., 416, this Court said :

> " One of the grounds upon which courts of " equity refuse relief where the party is guilty of " laches is the injustice of imposing upon the de- " fendant the necessity of making proof of trans- " actions long since past in order to protect him- " self in the enjoyment of rights which, during a " considerable period, have passed unchallenged " by his adversary, with full knowledge of the cir- " cumstances."

This principle of equity jurisprudence is, of course, applicable to patent and trade-mark suits, and has been followed by the Circuit Court of Appeals in the following well-known cases :

In Prince's Metallic Paint Co. vs. Prince Mfg. Co., a purchaser on foreclosure of a property and business which had long been conducted in connection with a trade-mark, continued to use the trade-mark, with full knowledge of the former owner, for eight years without objection. The Court said :

" In courts of equity the rule is to withhold re- " lief where there has been unreasonable delay in " prosecuting a claim, or long acquiescence in the " assertion of adverse rights. Again and again it " has been judicially decided that nothing can call " into activity a court of equity but conscience, " good faith and reasonable diligence. In " McLaughlin vs. Railway Co., 21 Fed., 574, Judge " BREWER held a bill for infringement of a patent, " alleging use and construction of a patented in- " vention for 13 years without stating an excuse " for the plaintiff's delay in suing, to be demur- " rable. Laches for even less than the statutory " period of limitations, aided by other circum- " stances, will bar a right (Ashhurst's Appeal, 60

" Pa. St., 290). In Lewis vs. Chapman, 3 Beav.,
" 133, the Master of the Rolls refused an injunc-
" tion to restrain the infringement of a copyright
" solely on the ground of six and a half years' de-
" lay, where there was knowledge of the com-
" mencement and prosecution of the defendant's
" publication. Long acquiescence before filing a
" bill for an injunction, with full knowledge of the
" infringement, is deemed laches equivalent to a
" breach of good faith (Brown, Trade-mark, § 497).
" Hence in Manufacturing Co. vs. Garner, 55
" Barb., 151, a delay of nine years in applying for
" an injunction to restrain infringement of a trade-
" mark was held to be a good cause for refusing
" it." The bill in the above case was dismissed.

(C. C. A., Sept., 1893.) Prince's Metallic Paint Co. vs. Prince Mfg. Co., 57 Fed., 938 (944) ; affg. s. c., 53 Fed., 493.

In La Republique Francaise vs. Schultz the defendant had for 30 years manufactured and sold " Vichy water," during which period his said business had grown to a large and profitable one. He always associated his name with his product, and advertised it as " Schultz's Vichy Water " (just as the defendant in the present suit has always advertised its product as " Holzapfel's Rahtjen's Composition " or " Rahtjen's Composition, Holzapfel's Manufacture "). Judge WALLACE, in deciding this case at circuit, said :

" Equity is indisposed to assist parties who
" have slept upon their rights and acquiesced in
" their appropriation by others for a great length
" of time. The unexampled delay and acquiescence
" in the present case, I think, should defeat the
" action." The bill was dismissed.

(C. C., May, 1899.) La Republique Francaise vs. Schultz, 94 Fed., 500 (since affirmed by the Circuit Court of Appeals).

In Starrett vs. Stevens Arms and Tool Co., it appeared that the complainant was aware ten years before bringing suit that the defendant was manufacturing and selling the alleged infringing device, and that at that time complainant had a correspondence with defendant in reference to the proper construction of complainant's patent and alleged infringing device made by defendant, but did nothing more to pursue his claim for the following ten years, during which time defendant continued to manufacture the alleged infringing device, and built up a large and profitable business therein.

(The present case is even stronger than this, since no claim or demand was made by the complainant or its predecessors on the defendant or its predecessors before suit was brought, 16 years after the alleged infringement commenced.)

The Court said :

> " It would operate as a great injustice at this
> " late day to interfere with an established business
> " conducted under an open claim of right for so
> " many years. The laches in this case are such as
> " to debar not merely the claim for profits, but
> " any claim to the interposition of a Court of
> " equity ; " and the bill was dismissed.
>
> (C. C., July, 1899.) Starrett vs. Stevens Arms & Tool Co., 96 Fed., 244.

In Richardson vs. Osborne & Co. the complainant for about fourteen years witnessed the infringement of his patent by the defendant, during which time the defendants expended time and money in building up their business. The Circuit Court of Appeals, in deciding the case, said :

> " The complainant says he sent notices to the
> " manufacturers, and, among others, to the de-
> " fendant corporation, in the latter part of 1883,
> " and met the president in Lake City by appoint-

" ment in January, 1884. He says: 'We had
" ' some conversation. He asked what our claim
" ' was. He was told it was on the combination.
" ' We talked together perhaps fifteen minutes
" ' pleasantly.' In May, 1890, an action at law
" was brought against the Minneapolis Harvester
" Works, which was compromised before trial, in
" September, 1891, by the payment of money and
" a release by the complainant. He did not tell
" how much money was paid or whether it was
" in recognition of the validity of the patent.
" For aught that appears, all that the defendant
" did was to pay a trifling sum to be free
" from a lawsuit. No other proceedings
" were instituted until the present suit. The
" only thing which can be during the entire
" history of the invention characterized as an
" active exercise of ownership was the Minneapolis
" suit, and its outcome is so vague and shadowy
" that it cannot be told whether it was a successful
" or an abandoned attempt to sustain the patent.
" The continued refusal or neglect of the joint
" owners to impart life to it was so manifest, that
" a Court cannot look with favor upon the present
" attempt to gain money from manufacturers who
" invested in the effort to supply the demands for
" the Appleby machines, under the belief that it
" infringed no patent, a belief which the conduct
" of the owners of the Fowler Patent encouraged."
The decision below dismissing the bill for laches was affirmed.

(C. C. A, Apr. 1899). Richardson vs. Osborne & Co., 93 Fed., 828, affirming, s. c., 82 Fed., 85.

In the present suit (whether we consider the 16 years in England or the 12 years in the United States, of the uninterrupted use of the alleged trade-name, by the defendant or its predecessors) there was such in-

excusable laches that the decree of the Circuit Court dismissing the bill of complaint, should have been affirmed by the Circuit Court of Appeals.

VI.

The Rahtjen Company's petition for a cross writ of certiorari.

The complainant, in the Courts below, viz., Rahtjen's American Composition Company, have filed a petition for a writ of *certiorari*. This is for the purpose of reviewing so much of the decision below that declines to award them an accounting.

Upon all the foregoing facts, and in view of the decision of every Judge before whom this case has come declining to grant an accounting, we confidently submit that said petition will be denied.

Conclusion.

We respectfully urge upon the Court that this case partakes of an international and public interest, not only affecting the whole maritime world, but being of especial interest to the Government of the United States. It is in evidence on the record, as the Court will see, that the complainant admitted, by the witness Petersen (Record, p. 33, x-Qs. 187–190), that the main reason for bringing suit was the successful competition and underbidding by the defendant in the matter of price for this paint for the Navy Department. In this respect the Government of the United States is an

interested party in this case, in the efforts of the defendant to break down a monopoly, secure healthful competition and lower prices to the great benefit of the Government. The case is also of great international interest, as if the present decision be allowed to stand, it will make an article of prime necessity in the shipping world, a monopoly in the United States, while subject to free competition in every other country. If the decision of the Circuit Court of Appeals stands, while it will be legal for anyone to sell under the brand of "Rahtjen" a paint for ships' bottoms in Great Britain and elsewhere in Europe, the same paint with this brand on it cannot be obtained in the United States unless by paying tribute to the monopoly which will result from the present decision. What will be lawful and proper in the whole shipping world outside of the United States, will be prohibited here. An article in which the name is part of the thing itself, woven into the very fibre of its existence, will here become an exclusive property under that monopolistic form which is odious to the law, while free as air to the use of every one outside the jurisdiction of this Court.

It is respectfully submitted that the case be remanded to the Court below with instructions to affirm the decree of the Circuit Court dismissing the bill of complaint.

JOHN G. CARLISLE,
WM. MC. ADOO,
R. B. MCMASTER,
Counsel for Holzapfels' Compositions Company Ltd.

1092
Office Supreme Court U.S.
FILED
MAY 9 1901
JAMES H.

No. 267. 54.

Sup'l Brf. of Carlisle, McMaster & Lee

Filed May 9, 1901.

Supreme Court of the United

OCTOBER TERM, 1900.

No. 267

HOLZAPFEL'S COMPOSITIONS COMPANY, LIMITED,
Petitioner,

against

RAHTJEN'S AMERICAN COMPOSITION COMPANY,
Respondent.

Supplemental Brief for Petitioner.

J. G. CARLISLE,
WM. McADOO,
R. B. McMASTERS,
For Petitioner.

C. G. Burgoyne, Walker and Centre Streets, N. Y.

10926

Supreme Court of the United States.

HOLZAPFEL'S COMPOSITIONS COMPANY, Limited,
Petitioner,

AGAINST

RAHTJEN'S AMERICAN COMPOSITION COMPANY,
Respondent.

October Term, 1900.
No. 267.

Roughly stated, the propositions contended for in the oral argument, to which the respondent's supplemental brief is a reply are as follows :

First. That even if the goods imported from Germany to be sold here by Gelien were marked " Rahtjen's Composition "—which we do not admit—they were manufactured in that country and marked there by the manufacturers who resided there, and, therefore, the trade-mark—if there was one—was foreign and not domestic ; that Gelien never placed any mark on the goods to indicate their origin or to distinguish them from like goods sold by others, or made any attempt to establish a trade-mark here ; that the " show card " issued by him was not a trade-mark but a mere advertisement, and was never attached to the goods ; that no matter whether the trade-mark—if

there was one—which was on the goods when sold here was foreign or domestic, it was discontinued and permanently abandoned in 1877, when Rahtjen ceased to make shipments to Gelien; and that after that date, all goods shipped to this country were manufactured in England and marked there during the life of the patent and afterwarks by Suter, Hartman & Company and their successors in the manner to be hereinafter stated.

Gelien's deposition was taken by respondent, but he was not asked to state, and did not state, how a single package sent to him for sale was marked (R., 165). His invoices, however, were filed, and were exhibited on the oral argument. They show that the words "Rahtjen's Composition" were not used in a single instance during the whole period from 1871 to 1877. It was always "Composition Paint" except once, and then it was "Pat. Composition." In his letter to Rahtjen dated January 27, 1877 (R., 117), he speaks of it simply as "Composition," and in his letter to Suter, Hartmann & Company of February 27, 1875 (R., 191), he twice calls it "Rahtjen's Patent Composition."

The depositition of John Rahtjen was also taken by the respondent, and on cross-examination he was asked:

"Q. When did you change your stencils from those berring the words 'Rahtjen's Composition' to those bearing the words 'Rahtjen's Patent Composition?' A. I do not remember.

"Q. Was it about the time that the Heinrick Rahtjen patent was issued? A. It may be; I don't remember. It was quite immaterial to us whether 'Rahtjen's Patent Composition' was on the casks or

packings, or 'Rahtjen's Composition,' if only those two words appeared in them."

R., 149.

Again, when speaking of certain casks which he had personally examined, he was asked:

"Q. Are you sure that the stenciling on that cask was 'Rahtjen's Composition?' A. It was either 'Rahtjen's Patent Composition,' as long as we had the patent, or 'Rahtjen's Composition' afterwards.

"Q. But you do not remember which it was, as a matter of fact, on that cask or keg? A. During the time the patent was in existence we used the word 'Patent,' and we dropped it afterwards. That is what I remember of it.

"Q. I am asking you now, however, in regard to your recollection of that visit when you made an inspection of the contents of this drum or cask or both; and I am asking you whether you remember that the words on that cask were simply 'Rahtjen's Composition' or whether they might have been 'Rahtjen's Patent Composition'? A. Well, I did not make any difference; I did not know any difference" (R., 151).

Again, he was asked:

"Q. How were the barrels or casks of Rahtjen's Composition marked that were sent to Gelien and Hartmann, Le Doux & Maecker by you? A. Those to Gelien on the one side with 'H. G.' and the number and 'Hoboken', and on the other side 'Rahtjen's Composition' or 'Rahtjen's Patent Composition'; and those to Hartmann, Le Doux & Maecker on one side 'H., Le D. & M., New York', and on the other side 'Rahtjen's Composition' or 'Rahtjen's Patent Composition'."

The English Patent was dated November 29, 1873, and in 1875 Rahtjen himself commenced the manufacture in that country, but he continued to furnish Gelien from the German factory until the beginning of the year 1878, and on the 15th of January in that year he gave Suter, Hartmann & Company of London the exclusive right to sell in the United States (R., 198). See also Hartmann testimony hereinafter quoted showing how Rahtjen marked his goods in Germany before and during the year 1871. There can be no doubt, we think, that from 1871 to 1878 the goods sent to this country for sale, if marked at all, were marked "Rahtjen's Patent Composition," which was a fraud upon the public and could not establish a valid trade-mark. The motive of the manufacturer or vendor in so marking them is immaterial. The public here naturally supposed that the manufacture and sale of the article were protected by a United States Patent, and a monopoly was thus secured which gave the article a reputation and value in the market. The Court below therefore was in error when it found, as matter of fact, that a valid trade-mark had been established in the United States prior to 1880.

Second. That no valid trade-mark was acquired in England by Rahtjen or by Suter, Hartman & Company before the patent was procured, and that therefore no trade-mark existed in that country after the termination of the patent, November 29, 1880, unless it was lawfully acquired there after that date; that such trade-mark, if any was lawfully acquired there after that date, which included the word "Rahtjen," was qualified and restricted by an express dis-

claimer of the exclusive right to use that word; that this qualification and restriction constituted an inherent part of the trade-mark itself and limited its effect in every country where it is relied upon as a protection; that from the termination of the patent in 1880 up to 1883 no mark was used in England on the goods shipped from that country except "Rahtjen's Patent Composition;" and after April 25, 1883, the only mark which the manufacturers and vendors had the exclusive right to use was that registered by Hartmann Brothers containing the words "Genuine Composition" with the red hand and "Hartmann's Manufacture."

Was a valid trade-mark acquired in Great Britain before the date of the patent? On this point the testimony of Hartmann, respondent's chief witness, is conclusive. We quote from his testimony:

"Q. I show you plaintiff's Exhibit V. Please examine the same and state what it is? A. It is a label of 'Directions for use' that we used *from the very outset of our career* as sole consignees for Rahtjen's Patent Composition. It bears my signature, 'None 'Genuine without this signature. Suter, Hartmann & 'Company.'

* * * * * *

"Q. What use was made of those labels, if you know? A. *They were put on the packages* that were sent to our different agents and customers.

"Q. By whom were those labels affixed to the packages? A. In the outset we sent them to Rahtjen when he manufactured the paint for us in Germany, and subsequently when Mr. Rahtjen made the paint for us in England they were sent to him to be put on the packages.

" Q. How long were the labels, such as the sample in evidence, used to mark the goods sold by your firm, if you know ? A. For several years."

The witness was then shown a circular (Exhibit W), and was asked the following questions :

" Q. What is the matter on the third page of the circular ? A. Directions for use for No. 1 and No. 2 and No. 3.

" Q. Of what, if anything, is the matter on page 3 in substance a copy ? A. Of the labels that were put on the packages.

" Q. State what use was made of the circular which you have produced ? A. It was sent to our different clients, and also agents, to make use of it, and the signature denotes that we were particular to uphold the name of Rahtjen as an additional element of security against bogus imitations.

" Q. As I understand, substantially, the subject matter of page 3 was used in the form of labels, and sent to Mr. Rahtjen, and by him affixed to the packages imported by you ? A. Yes.

* * * * * *

" Q. State whether or not this way of designating Rahtjen's compositions *was employed in Germany at the time you took the agency ?* A. It was.

" Q. Then this was in effect a copying of his method of describing it ? A. It was (R., pp. 60, 61).

* * * * * *

" Q. Referring to Plaintiff's Exhibit V, when did you first see those labels ? A. In January, 1871, or at the commencement of Suter, Hartmann & Company.

* * * * * *

" Q. How long did you use those labels ? A. For many years.

"Q. Up to about what time? A. I cannot tell the time or the number of years we had them in use, but they were *in constant use*, and great care was taken that they should be used, as we thought it an extra security for the name of Rahtjen to prevent spurious and bogus imitations.

"Q. Did your firm of Suter, Hartman & Company attach these labels to the casks, barrels and the like containing the composition, or did some other firm attach them? A. Mostly we did ourselves, and some were also sent over to Germany when we imported the composition from Germany and were attached to the packages there" (R. pp. 72, 73).

The label which was attached to the goods, and the circular referred to as Exhibits V and W, are printed on pages 192–194 of the Record, and they leave no room for doubt as to the markings actually used on the packages by Suter, Hartmann & Company from the very beginning of their business in England, and by Rathjen in Germany at the time they took the agency in 1871. The label put on the goods was "Rahtjen's Patent Compostion," etc., etc., and the circular which was issued in Januaay, 1871, at the same time the label was copied from the German label, had a heading in the same words, and announced to the public that the firm had been appointed "sole agents in the United Kingdom for the sale of the Above-Named Patented Compositions." In addition to all this evidence, certain bills for paints sold by Suter, Hartmann & Company, dated October 5, 1871, February 9, 1872, and February 10, 1872, were produced by the witness Hartmann, all of which describe it as "Rathjen's Patent Composition" (R., pp. 183-4).

This evidence and much more containted in the rec-

ord, shows that the article was falsely represented in England and Germany to be protected by a patent during the years 1871 to 1873, before the patent was actually obtained or applied for, and it shows the character of the marks put on the goods sent by Rahtjen from Germany to the United States during the same period, as well as the goods sold in England and sent to the United States by Suter, Hartmann & Company during the life of the patent and after it expired. It is not necessary to make an argument or cite authorities to show that trrade-marks can not be acqnired in this fraudulent manner.

The use of this false mark was continued all through the life of the patent and until 1884, when Suter, Hartmann & Company registered " Rahtjen's Patent Composition " in England, but expressly disclaimed the exclusive right to the use of the word " Rahtjen." In their application for this mark they swore that they had used " Rahtjen's Patent Composition " since about a year and a half before August 13, 1875 (R., p. 407). In June and July, 1883, John Rahtjen made two applications for the registration of trade-marks, one for " Genuine Rahtjen's Composition," and one for " Rahtjen's Composition." Both were opposed by M. Holzaphel & Company and both were abandoned (R., pp. 398–400). On June 28, 1883, Suter, Hartmann & Company applied for the registration of " Rahtjen's Patent Composition for ships' bottoms, buoys, etc. None genuine without this signature. Suter, Hartmann & Company." This was also opposed by Holzaphel & Company and was abandoned (R., pp. 402–5). The only legal trademark actually used in England at any time by any one who was engaged in the manufacture or sale of the paint, as the owner, was the one registered by Hart-

mann Brothers on April 25, 1883, and known as the "Red hand." They did not claim to have used this mark before the date of the application, and, therefore, did not fill in the blank left for the insertion of a statement on that subject (R., pp. 408–9). It was a new mark and omitted the word "Rahtjen" because they could not lawfully appropriate the exclusive use of that word. After Suter, Hartmann & Company had, in 1884, reigistered with a disclaimer, the parties wrongfully attempted to establish an exclusive right to the use of the word "Rahtjen" by incorporating it into the "Red hand" trade-mark, and this is the sole basis of the present company's claim to the exclusive right to the use of that word. This combination of the two English trade-marks is the one used by the respondent on goods imported into this country in 1898 at the time of the alleged infringement.

On April 23, 1878, Rahtjen having ceased to make shipments to Galien in 1877, Hartman, Le Doux & Maecker announced by publication in New York that they had been "appointed sole consignees in the United States of 'Rahtjen's Patent Composition'" (R., p. 190). They received their goods direct from the English factory with the English mark "Rahtjen's Patent Composition on them." The witness Hartman praduces and files certain invoices of paints sent to Hartman, Le Doux & Maecker in the years 1879, 1880, 1881, 1882 and 1883, in which the goods are described as "Rahtjen's Patent Composition" (R., p. 195). There is no evidence to show that they were sold here under any other mark. On June 23, 1885, Hartman, Le Doux & Maecker, the agents for the sale of the paint here, registered a mark in the United States consisting

of the word "Rahtjen's Composition," which had been adopted, as they say in their application, "for our use" (R., p. 210). They were not manufacturers of the goods nor were they owners, but only vendors, as agents for the manufacturers and owners. We insist that this was not a valid trade-mark; (1) because it was adopted by mere agents or salesmen for themselves as agents or salesmen; (2) because there is no evidence that it was ever actually used by them on goods sold in the market, which is necessary to establish a trade-mark here, though not so in England under the statute; and (3) because long before the date of the application the petitioners had been selling the paints here and using the word "Rahtjen" on their packages and in their advertisements, etc.

The respondent claims this alleged trade-mark by assignment, but there was really nothing to assign. Trade-marks may be assigned in connection with the business and good-will of the owner, but even if agents could acquire a right for themselves as such, they possessed no business or good-will except as agents for somebody else, and this they could not sell because the business and good-will of an agent terminate when the agency ceases.

On December 14, 1888, Suter, Hartmann & Rahtjen's Composition Company (Limited), an English corporation which had been recently organized, filed an application in the United States for the registration of the "Red hand" trade-mark which had been registered, as before stated, in England in 1883. It is minutely described in the application and it is therein stated that it had been continuously used by the applicant and his predecessors *since January, 1884* (R., 211).

10931

The parties then combined the two last-mentioned marks, just as they had previously done in England, and now claim the exclusive right to use the word "Rahtjen" in this country.

Between the 21st day of April, 1883, and the 23d day of October, 1886, the firm of Holzapfel & Company, the predecessors in business of the petitioner, registered no less than five trade-marks in England, all of which included the word "Rahtjen's," though they were required, as was Suter, Hartmann & Company, to disclaim the exclusive right to use that word. These registrations were parts of the public records and were known to the respondent's predecessors.

On the 23d day of March, 1889, the same firm registered a trade-mark in the United States which was similar to those registered in England, and consisted of three vertical parallelograms, on the central one of which was the fac-simile signature "Holzapfel & Co.," and above the parallelograms the initials and abbreviations "H. & Co.," and below are the words "Stir well before using," the whole surrounded by a circle composed of the words "Genuine Rahtjen's Patent Composition for Ships' Bottoms." And on the 4th of May, 1897, the firm registered in this country a further trade-mark, consisting of the representation of a propeller in connection with the words "Holzapfel's Compositions" in plain block capitals printed in black in a curve above the propeller. These are the marks used by the petitioner at the time of the alleged infringement.

Copies of all these registrations in England and here are on file with the Clerk of this Court, but are not printed in the record.

In 1883 or early in 1884 Holzapfel & Company commenced the manufacture of this composition in England for sale there and for exportation. Their first agent for the United States was appointed July 23, 1884, and before the date of the alleged infringement no less than thirty-nine persons and firms had been appointed and made sales in this country (R., 271-2). The testimony shows that the word "Rahtjen" invariably constituted a part of the marking of the goods manufactured and sold by them both in England and in the United States. M. Holzapfel testified as follows:

"Q. Now, when you formed the copartnership of M. Holzapfel & Company with your brothers and cousins and commenced the manufacture of said composition, how did you put it up and how did you mark it? A. The composition for home use we put up in wooden barrels; the composition for export we put up in iron drums. After 1883 we marked the composition according to the registered trade-mark, 'Rahtjen Composition' or 'Genuine Rahtjen's Composition for Ships' Bottoms.' The No. 3 with parallelograms in centre. The composition was advertised as 'Genuine Rahtjen's Patent Composition.' In 1886 or 1887 we added the propeller to this trade-mark.

"Q. Where did you manufacture and sell under the copartnership name of M. Holzapfel & Company the 'Genuine Rahtjen's Composition' or 'Genuine Rahtjen's Patent Composition?' A. It was manufactured at Gates' Head on Tyne, and was sold to most maritime countries in the world.

"Q. And during the continuance of the firm of M. Holapfel & Company this composition was put up in the manner and with the mark substantially as de-

scribed by you in your preceding testimony? A. Yes" (R., 263).

Again:

"Q. At the time that M. Holzapfel & Company began to manufacture this composition and mark it as the 'Genuine Rahtjen's Composition' or 'Rahtjen's Patent Composition' on the vessels containing it, how did Suter, Hartmann & Company mark the vessels containing the composition made by them? A. At the time we commenced to manufacture Rahtjen's composition and to mark it as previously described, Suter, Hartmann & Company still adhered to their old marks, as shown in the photograph.

"Q. You say in your previous testimony that this composition manufactured by M. Halzapfel & Company was sold in most maritime countries of the world. Was it ever sold in the United States to your knowledge, and if so, when and first, as near as you can tell? A. It was first sold in the United States in 1884 and has been sold there continously since.

"Q. Under what name or mark was it sold in the United States? A. It was marked 'Rahtjen's Anti-Fouling Composition for Ships' Bottoms' in a circle; three parallelograms in the centre; 'H. & Co.' over the parallelograms, and the words 'Stir Well Before Using' below the parallelograms, and it was invoiced as 'Genuine Rahtjen's Patent Composition.'

* * * * * *

"Q. Did the firm of M. Holzapfel & Company have another agent in the United States for the sale of said composition? A. Yes; we had several agents at several ports. To New York we first sent a man from Europe, called Perry, to represent us; later on, the agency was transferred to McCaldin Brothers, and after

that to Mr. John A. Donald. In San Francisco, we had A. C. Dietz & Company ; at New Orleans, Woodward, Wight & Company. We had agents at Boston, Philadelphia & Baltimore, but their names have escaped my memory.

" What was done with the business of M. Holzapfel & Company when the present defendant Company was formed ? A. The assets, good-will and trade-marks were sold to the present limited company " (R., 264–5).

The witness Scnitger, who was connected with the business from 1883, testified as follows :

" Q. Now, as to the marking of the vessels containing the said composition, which the firm of Holzapfel & Company made and sold, state whether or not the name ' Rahtjen's ' or ' Rahtjen's Composition ' or words substantially to that effect appeared anywhere thereon ? A. I drew up the first stencil plate on a sheet of paper in pencil and it certainly contained the word ' Rahtjen's,' but whether it contained the words ' Rahtjen's Patent ' I cannot say. The wording was ' Genuine Rahtjen's Composition ' or ' Genuine Rahtjen's Patent Anti-Fouling Composition for Ships' Bottoms.'

" Q. You are positive it contained the word ' Rahtjen's ' ? A. Certainly.

* * * * * *

" Q. Do you know whether the firm of L. Holzapfel & Company during your connection with it ever sold any of the so-called Rahtjen's Composition in the United States ? A. I know we consigned some to one firm. That is all I know about that.

" Q. Do you know the name of the firm ? A. I can't tell you exactly—Woodward, Wright or White, or something like that.

"Q. Do you remember when that was? A. I should say it was the end of 1883 or the middle of the year 1883.

* * * * * *

"Q. Do you remember whether or not this composition which was consigned to you or sold to parties in the United States by M. Holzapfel & Company during your connection with that firm was marked with the word 'Rahtjen's' or with any title of which the word 'Rahtjen's' formed a part? A. Certainly, it was marked with the word 'Rahtjen's.' It was marked 'Rahtjen's Genuine Composition' or 'Genuine Rahtjen's Anti-Fouling Composition for Ships' Bottoms.' That was the first marking" (R., 294–5).

A. C. Holzapfel testifies:

"Ever since my connection with the defendant company, we have advertied all our goods and amongst them prominently Rahtjen's composition, which has occupied about one-fifth or one-sixth of the space taken up by our advertisements. The total sum spent on advertisements is between 1,500 pounds and 1,800 pounds a year and has been so since 1887."

And in answer to further questions he says:

"Q. Now, prior to the formation of the present company, do you know whether their predecessors, Holzapfel & Company, advertized the said composition as made and sold by them, and, if so, how much they expended in advertisements? A. Rahtjen's and the International compositions were both adversed from 1883 onwards, each occupying about half of the space of the advertisement until further compositions were added to those manufactured by us in 1887. Therefore, Ratjen's composition from 1883 to 1887 occupied about one-half of our advertisements and the sums spent dur-

ing those years are from 1,000 pounds, progressing upwards to 1,500 pounds, as time advanced.

* * * * * *

"Q. How has the defendant company or their predecessors in business, Holzapfel & Company, marked said composition in the past and at present, so far as your knowledge extends; that is, have they or not always marked it with the name of which the word 'Rahtjen's' formed a part? A. The name 'Rahtjen's' was invariably marked on the vessels containing such composition.

"Q. And as manufactured by whom? A. Our name as manufacturers was always identified with the goods.

"Q. Was there any concealment of the fact that they were manufactured by Holzapfel & Company or by the defendant company, or any suggestion that they were the goods manufactured by Suter, Hartmann & Company or their successors in business? A. It was never suggested or attempted to be suggested that the Rahtjen's Compositions sold by us was manufactured by Suter, Hartmann & Company. Since 1887 or 1888, our trade-mark of a propeller was also added as a further distinguishing mark to these goods. Before that they were marked with one or the other of the registered trade-marks of Holzapfel & Company which are in evidence in this suit" (R., 330–1).

The fact that the petitioner and its predecessors sometimes used the word "Patent" in marking packages is wholly immaterial, as it is not claimed or necessary to claim that they had, or now have, the exclusive right to the use of the word "Rahtjen's." The respondent, in order to maintain its action, must show an exclusive right in itself to use that word, while the petitioner is simply defending a right which is common to all.

Third. That even if there ever was a valid trademark in Great Britain, Germany, or the United States, which included the exclusive right to use the word "Rahtjen" it has long ceased to exist, and the word became public property; that it certainly became *publici juris* in Great Britain on the termination of the patent in 1880, and the courts in Germany and Belgium have decided that it became public in those countries at the same time; that the exclusive trade in the article was in fact secured and protected by the patent throughout the maritime world by the patent itself and by the representations of the parties, not only before it was obtained and while it existed, but for several years after it expired; that the reputation and market value of the article were established by the patent and by the representations made to the public before and after the patent, and not by the use of the word "Rahtjen's;" that "Rahtjen's Composition" is simply the name of the article, and has long since ceased to indicate its origin or vendor, and that the words were used by the petitioner for that purpose only at and before the time of the alleged infringement, and, taken in connection with the other words and marks used on their packages, distinctly advised the public that the respondent was not the manufacturer or seller.

J. G. CARLISLE,
WM. MCADOO,
R. B. MCMASTERS,
For Petitioner.